



APPN: 09/1 34,831

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27438  
#34

APPN: 09/1 34,831

Filed: August 17, 1998

Applicant: Richard P. Mettke

Title: On-line Communications Terminal/Apparatus

Group Art Unit: 2743

Examiner: Stella Woo

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Technology Center 2600

### EX PARTE APPEAL PETITION TO THE COMMISSIONER OF PATENTS

#### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited on  
with the US Postal Service with return  
Receipt requested. The envelope was addressed to:  
Commissioner of Patents and Trademark, Box AF,  
ATTN: Appeals to the Commissioner, Washington DC, 220231

Commissioner of Patents and Trademarks,  
Box AF,  
ATTN: Appeals to the Commissioner  
Washington D.C. 20231

RECEIVED  
DEC 13 2002  
OFFICE OF PETITIONS

Dear Commissioner of Patents and Trademarks,

In accordance with Code of Federal Regulation 37, section 1.181, I am filing an ex parte petition to invoke the **supervisory authority** of the Commissioner. Enclosed is a check in the amount of \$ 130.00 as prescribed in the USPTO fee schedule as required for this action.

The basis for this appeal are the actions of the Examiner involved with the prosecution of my Reissue Application. I feel that many of the Examiners office actions have been **non-responsive** as well as **unobjective**. I have presented a *prima facie* case for the allowance of the claims in my

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reissue application. This is not a case of sour grapes on my part.

Specifically, the examiner has refused to objectively consider prima facie arguments countering her claims that my application is not patentable over three pieces of prior art that the Examiner claims makes my claims obvious (35 USC, 103). The three pieces of art that Examiner insists render the Applicants claims obvious are, (1) an article entitled “ *TouchFax Provides the Ultimate in Place-based Interactivity*” ( Exhibit E), enclosure 3 , (2) Touchfax brochure entitled “*Vision, Power, Versatility*” (Exhibit F) enclosure 4 and (3) an article that was posted on the WWW, “ *Suggestions for Information Kiosk Systems using the World Wide Web*” by Rawn Shah (Exhibit I), enclosure 5.

Although the applicant has submitted numerous responses directed towards assisting the examiners interpretation of the prior <sup>Art</sup> that she cites, the Examiner insists on her flawed interpretation of the elements of the Prior Art that is cited. It has been obvious that the Examiner has not been objective. The Examiner has refused to elaborate on why the applicant’s arguments were not persuasive in numerous Office Actions. A comparison of the Applicants responses against the Examiners Office Actions proves out this contention. The examiner has improperly combined Prior Art, which was not suggested. As far as the rejection of the Applicants claims for Obviousness, the Examiner has not followed procedure. Specifically, the examiner must show an unrebutted *prima facie* case of obviousness. If a proper *prima facie* case of obviousness is not established, then an applicant complying with the other requirements of the patent statute is entitled to the grant of a patent. If a proper *prima facie* case of obviousness is established, then an applicant can overcome the obviousness rejection by: (1) showing that the evidence of *prima facie* obviousness is insufficient, or (2) rebutting the prima facie case of obviousness with

evidence of secondary indicia of nonobviousness. The factual findings underlying an obviousness determination include (1) the scope and content of the prior art, (2) the differences between the prior art and the claimed invention, and (3) the level of ordinary skill in the art. When an obviousness rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. **There is no suggestion to combine in any of the Prior Art that the Examiner cites. The applicant has met this burden.** Furthermore, the applicant has provided **other** persuasive arguments to suggest that the prior art that the Examiner cites is irrelevant or improper as they relate to the applicant's claims.

The Applicant provided the Examiner an affidavit (Enclosure 6 and Enclosure 13) from a Subject Matter Expert, skilled in the Art in a response to an Office Action, dated, 3-11-02. Included in the Affidavit was a matrix that clearly articulated all elements of the Prior Art cited by the Examiner and the Applicants claims. The Prior Art cited by the examiner does not have every element cited by the Applicants claims. The Examiner did not address the affidavit in any response to the Applicant. In fact, the applicant provided a 19 page response, in his response to USPTO office action dated 4-25-02 (enclosure 13), the examiner responded with a one page response. In an Office Action dated 5-15-02 (enclosure 14) the examiner stated that the Applicant needed to remove various passages from the reissue application because the Examiner deemed it "new matter". The Applicant complied (or so was thought). In a following Office Action, the applicant made the changes/amendments in a response to an Office Action. The Examiner stated in a subsequent Office Action that the Applicant still needed to make some changes. The Applicant was under the impression that all changes had been made and asked the Examiner to "**specify**" what changes still needed to be made. The examiner was non-responsive.

There have been no fewer than six office actions during the prosecution of this reissue. The Examiner needs to specify what changes were not made in such a complicated action. The Examiner has an obligation to objectively consider all facts and matters presented in support of an application. Furthermore, an Examiner has an obligation to elaborate on matter presented to mitigate prior art and the rationale to accept or not accept and arguments. This was not the case as it relates to this application.

Because of the number of Office Actions and responses, I have provided as enclosures, the complete copies of all actions (to the best of the Applicants knowledge). The applicant has on many occasions requested constructive assistance and suggestions pursuant to MPEP 707 07 (j), to no avail.

I realize that when an applicants pursues a reissue for a patent that the original patent letters is open for "attack", but I believe that in this case the Examiner did not follow MPEP procedures and that her actions leave the USPTO open to credibility questions.

The Applicant respectfully requests that the rejections be withdrawn and allowance be provided.

The applicant has made a diligent effort to amend the application so that it is at an allowable state that defines a novel structure, unobvious because it produces new and unexpected results at the time of the application.

Respectfully request your expedited assistance in this matter. This action has been pending/working for over **four years**.

Sincerely,



Richard P. Mettke

Ex parte,

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Email: rmettke@aol.com

**Enclosures:**

- Enclosure 1-** US Patent, 5,602,905 On-line Communication Terminal /Apparatus
- Enclosure 2-** Reissue Application/Amendment, 8-17-98
- Enclosure 3-** Exhibit E, *TouchFax Provides the Ultimate in Place-based Interactivity*
- Enclosure 4-** Exhibit F, Touchfax brochure entitled "*Vision, Power, Versatility*"
- Enclosure 5-** Exhibit I, *Kiosk Systems using the World Wide Web* by Rawn Shah
- Enclosure 6-** Statement by Mr. Greg Adank, Subject Matter Expert, 4-6-02
- Enclosure 7-** USPTO Office Action, Examiner Woo, 8-24-99
- Enclosure 8-** Response to Office Action of 8-24-99, Dated 11-22-99
- Enclosure 9-** Decision on Petition to Withdraw Holding of Abandonment, 4-13-01 \*\*
- Enclosure 10-** USPTO Office Action, Examiner Woo, 6-8-01

- Enclosure 11-** Response to Office Action of 6-8-01, Dated 12-5-01
- Enclosure 12-** USPTO Office Action, Examiner Woo, 3-11-02
- Enclosure 13-** Response to Office Action of 3-11-02, Dated 4-25-02
- Enclosure 14-** USPTO Office Action, Examiner Woo, 5-15-02
- Enclosure 15-** Response to Office Action of 5-15-02, Dated 5-29-02
- Enclosure 16-** USPTO Office Action, Examiner Woo, 6-25-02
- Enclosure 17-** Response to Office Action of 6-25-02, Dated 9-16-02
- Enclosure 18-** USPTO Office Action, Examiner Woo, 10-11-02

\*\* The USPTO lost the Response to Office Action of 8-24-99, Dated 11-22-99 and issued an Abandonment notice. The entire file was lost and had to be reconstructed.

## United States Patent [19]

Mettke

[11] Patent Number: 5,602,905

[45] Date of Patent: Feb. 11, 1997

[54] ON-LINE COMMUNICATION  
TERMINAL/APPARATUS[76] Inventor: Richard P. Mettke, 620 Shannahan Dr.,  
Weaver, Ala. 36277

[21] Appl. No.: 376,247

[22] Filed: Jan. 23, 1995

[51] Int. Cl.<sup>o</sup> ..... H04M 11/00

[52] U.S. Cl. .... 379/96; 379/91

[58] Field of Search ..... 379/100, 91, 96,  
379/97, 98, 93, 94, 144, 155; 358/401,  
442; 235/380, 381, 382; 364/401, 408

## [56] References Cited

## U.S. PATENT DOCUMENTS

4,902,881	2/1990	Janko	235/380
5,008,928	4/1991	Cleghorn	379/144
5,218,633	6/1993	Clagett et al.	379/96

5,247,575	9/1993	Sprague et al.	379/100
5,272,747	12/1993	Meads	379/144
5,333,181	7/1994	Biggs	379/144
5,393,964	2/1995	Hamilton et al.	379/91
5,396,546	3/1995	Remillard	379/96

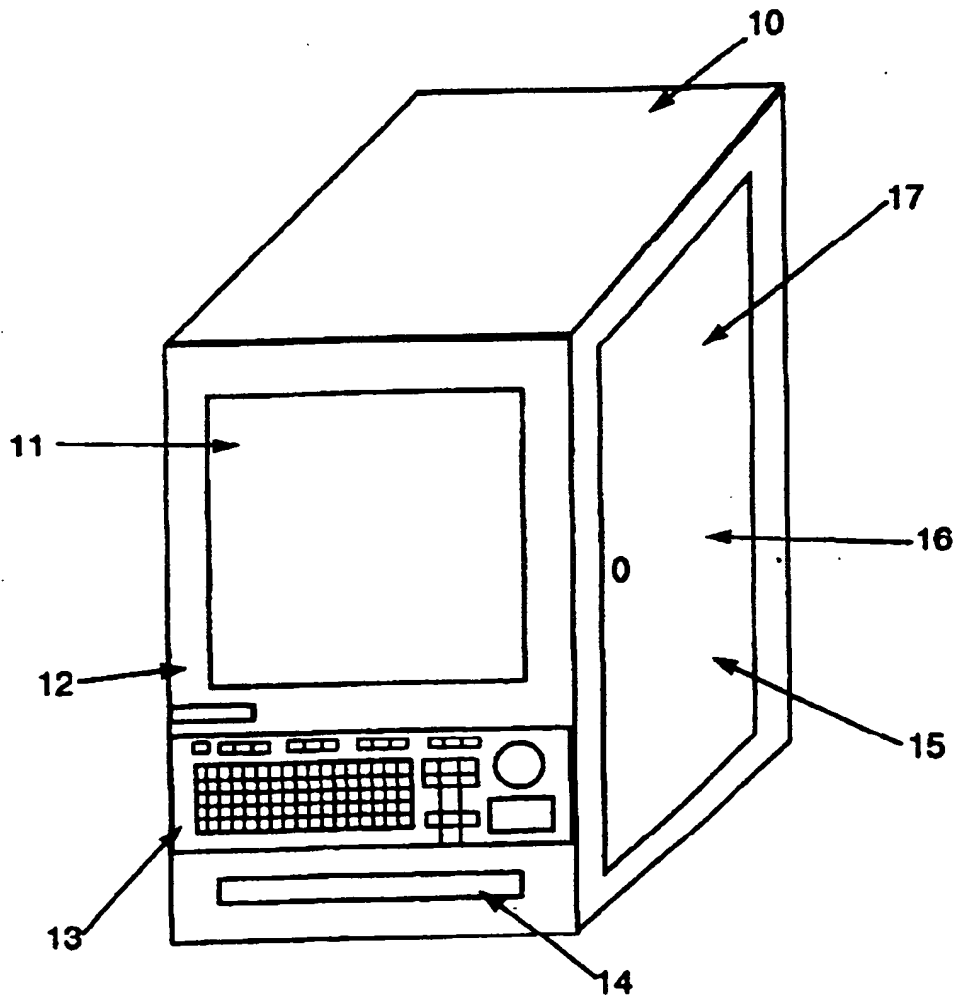
Primary Examiner—Curtis Kuntz

Assistant Examiner—Stella L. Woo

## [57] ABSTRACT

A "pay-as-you-use" communication terminal capable of interfacing with all major commercial on-line communications services (I.E. American On-Line, Prodigy, CompuServe, Genie, Delphi, Eworld). Users can receive a hard copy of any activity that they conduct from the terminal through the co-located printer. Payment of services will be made by credit card, using a "magnetic swipe" system included as part of the terminal system. Users will be charged for use of the system as well as normal telephone charges.

5 Claims, 1 Drawing Sheet



ENCL

Figure 1

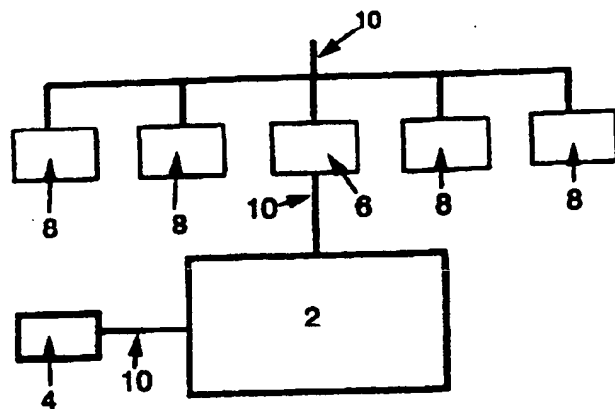
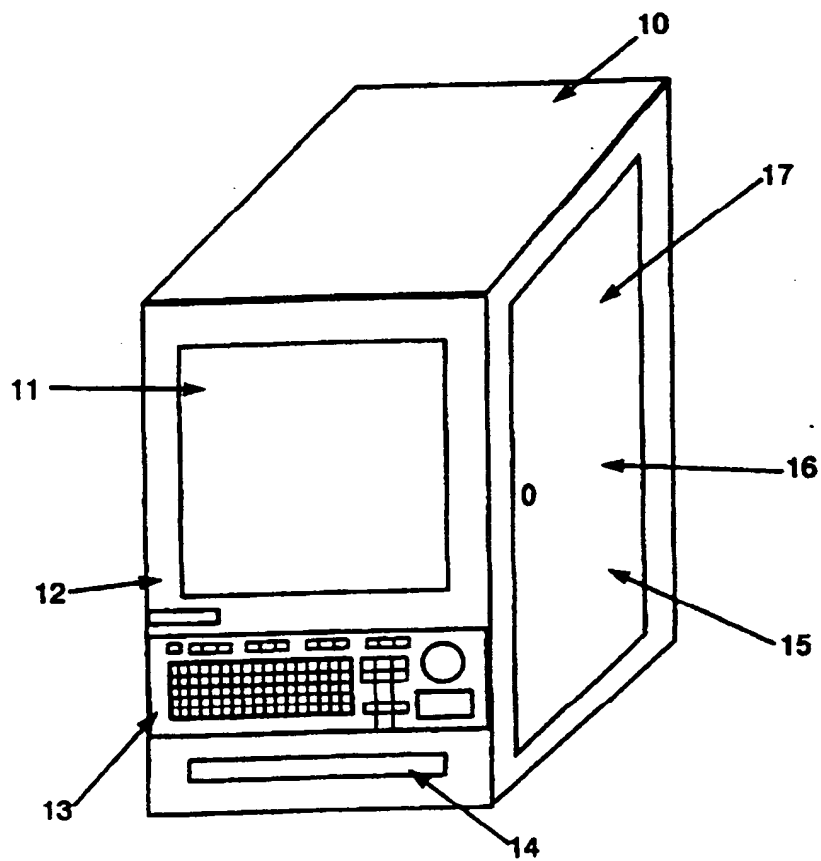


Figure 2



# 1

## ON-LINE COMMUNICATION TERMINAL/APPARATUS

### BACKGROUND—FIELD OF INVENTION

This invention relates to an electronic pay-as-you-use message terminal/apparatus capable of interfacing with all major commercial on-line services.

### BACKGROUND—DESCRIPTION OF PRIOR ART

In the past few years there has been a remarkable growth in the use of commercial on-line service providers (I.E. PRODIGY, COMPUSERVE, AMERICAN ON-LINE, and DELPHI) machines. The use of the above listed services are normally conducted in the home or office.

Individuals and businesses constantly draw from the wealth of data bases of information available from the commercial on-line services. Commercial on-line members also access the services for personal and leisure activities (I.E. play games, news or sports updates, weather reports, shopping, traveling, browsing ETC.) These services are generally accessed from fixed site locations at home or in the office. Although, portable terminals (lap top computers) with modems are available; they are often cumbersome and are not user friendly for a travelling business people or other users of commercial on-line services on the road.

There are various devices/apparatuses for conducting the operations/applications described previously. There is however, no one device/apparatus that brings these operations/applications together and offers their use on a pay-as-you-use basis. A listing of known prior art:

U.S. Pat. No. 4,092,527—A calculator with interchangeable keyboards having different preselected configurations of numeric and/or function keys.

U.S. Pat. No. 4,274,081—A data input apparatus including a keyboard and plurality of interchangeable mats which define the function of the 39 keyboard keys.

U.S. Pat. No. 4,374,381—A touch terminal which communicates and controls a microprocessor.

U.S. Pat. No. 4,482,955—A keyboard having an on board microprocessor for controlling keyboard functions.

U.S. Pat. No. 4,660,218—Automatic switch apparatus for automatically switching between a telephone set and a terminal device.

U.S. Pat. No. 5,334,823—Systems and methods for operating Data card terminals for transaction chargeback protection.

U.S. Pat. No. 5,235,680—Apparatus and method for communicating textual and image information between a host computer and remote display terminal.

As stated previously, the above cited prior art devices/apparatuses have provided the majority of the technical applications/capabilities for this on-line terminal; however none are brought together to provide for the pay-as-you-use applications/capabilities of this device/apparatus.

Accordingly, there is no one device/apparatus that allows a user, to access, on a pay-as-you-use basis, a commercial on-line service on an interactive basis. The terminals would be located in such diverse locations as airports, hotels, business centers, libraries, hospitals, shopping malls and other locations as appropriate.

# 2

## SUMMARY OF THE INVENTION

The present invention disclosed herein comprises a system for accessing commercial on-line services on a pay-as-you-use basis. The system includes a Central Processing Unit (CPU), internal modem, monitor, printer, credit card reading swipe device and housing. Accordingly, besides the objects and advantages of this device/apparatus described previously in my application, several objects and advantages are (some restated):

(a) Users can conveniently access commercial on-line services and the Internet at other locations other than from their fixed terminal at an office or home.

(d) Users can receive a hard copy document from a laser printer of any activity that they conduct at the terminal.

(e) Users will pay for the use of the terminal using a credit card swipe apparatus. The user will be charged for use of the terminal, telephone line use charges and additional charges by the commercial on-line service or internet provider.

(f) Commercial on-line services will benefit greatly by the additional exposure/access of their services.

(g) Users will have the convenience of having easy access to the services provided by the terminal at a reasonable price; negating the need for frequent travelers to unnecessarily carry around a cumbersome laptop terminal with accessories for conducting on-line activities.

### BRIEF DESCRIPTION OF THE DRAWINGS

FIG. 1 A typical functional embodiment is schematically illustrated by block diagram form in FIG. 1.

FIG. 2 A typical embodiment of the terminal is illustrated in diagram form in FIG. 2.

### DETAILED DESCRIPTION OF THE INVENTION

A typical functional embodiment is schematically illustrated by block diagram form in FIG. 1. Numeral 2 generally indicates the Terminal device which is comprised of the monitor, keyboard w/mouse, central processing unit w/internal modem (14.4-28 BPS), integrating software, laser printer, credit card swiping device, telephone and telephone lines. Numeral 4 generally indicates the credit card processing service/center. Numeral 6 generally indicates the local telephone node/switching node. Numeral 8 generally indicates the feeder/access nodes for the commercial on-line service/Internet provider. Numeral 10 generally indicates the servicing telephone line.

"A typical embodiment of the terminal is illustrated in FIG. 2. Numeral 10 generally indicates the housing for the terminal. Numeral 11 generally indicates the monitor. Numeral 12 generally indicates the credit card reader swipe device. Numeral 13 generally indicates the keyboard. Numeral 14 generally indicates the printer paper discharge chute. Numeral 15 generally indicates the location of the printer behind the terminals access door. Numeral 16 generally indicates the location of the CPU with internal modem behind the terminals access door. Numeral 17 generally indicates the location of the access door."

"A representative CPU with internal modem, monitor and printer could be of the IBM AST series. A representative touch screen with controller could be of the series manufactured by Interaction Systems. A representative credit card reader could be the MAGTEK 21055002."



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Interconnection and operatability of the components is not discussed in greater detail since the technology is well known in prior art.

Accordingly, the reader will see that this invention has unlimited potential and promise in this ever emerging information age. The invention would be a convenience for business people and travelers providing easy access to on-line services that are quickly become the norm in day to day living. While particular embodiments of this invention have been described for purposes of illustration, these involve no limitations and the invention may be carried into practice by persons skilled in the art in a variety of ways without departing from its spirit or from the ambit of the claims.

I claim:

1. A public on-line, pay-as-you-use communications terminal comprising a housing, wherein said housing contain:

a central processing unit (CPU);

a telephone access node;

an internal modem coupled to the CPU and telephone access node;

a video display monitor coupled to the CPU;

a keyboard for providing user interface coupled to the CPU;

a credit card reader swipe device coupled to the CPU for accepting payment by a user for use of the terminal; means for accessing commercial on-line services and allow for user interaction;

software installed into the CPU to allow interface with commercial on-line service providers and credit card service centers;

a printer coupled to the CPU.

2. The terminal in accordance with claim 1 wherein said means for accessing includes a touch screen interface

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attached to the monitor and further includes a touch screen means for accepting input information from said touch screen interface and modifying program execution accordingly.

3. The terminal in accordance with claim 1 also including, within said housing, program means for causing said printer to print a receipt or any other document available from a commercial on-line service.

4. The terminal in accordance with claim 1 wherein said housing includes a durable enclosure for the CPU, monitor, internal modem and printer, and a secured access door for service and repair.

5. A method of using a public on-line, pay-as-you-use terminal to access commercial on-line services comprising the steps of:

swiping a credit card through a credit card swipe device; if credit is is denied, disallowing interaction; if credit is approved, receiving charge approval from a credit card center for use of the terminal; communicating said approval to CPU executing a main program; in response to input from a user who is responding to a selection of on-line services that are assessable and displayed on a monitor in communication with said CPU and, based on interaction between said user and said main program, controlling switching means with said CPU to provide communication between a telephone access node and a modem with a commercial on-line service; printing with a printer a hard copy of documents said user requires, said printer being in communication with the CPU; deactivating said CPU from commercial on-line service user interaction on appropriate input from said user; printing with said printer a billing statement.

\* \* \* \* \*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application for Reissue of:                   §  
Patent No. 5,602,905                                   §  
Patentee:       RICHARD P. METTKE                   §  
Issued:         February 11, 1997                   §     Attorney Docket No.: 6388.005  
For:            ON-LINE COMMUNICATION           §  
                  TERMINAL/APPARATUS               §  
                                                                 §

REISSUE APPLICATION TRANSMITTAL LETTER

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

CERTIFICATE OF MAILING 37 C.F.R. 1.10	
I hereby certify that this correspondence is being deposited with the U. S. Postal Service as Express Mail, under Express Mail No. EL157449783US addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, Attn: BOX 7, on the date indicated below.	
<u>8-17-98</u> Date	<u>Reginald L. Stewart</u> Signature

Enclosed for filing please find the Reissue Application papers of Richard P. Mettke.

This application is a reissue of U.S. Patent No. 5,602,905 issued on February 11, 1997 for On-line Communication Terminal/Apparatus to the above named inventor. The following documents are enclosed:

1. Reissue Declaration of Richard P. Mettke pursuant to 37 C.F.R. § 1.63 and 1.175(a);
2. Power of Attorney;
3. Offer to Surrender;
4. Order for Title Report;
5. Information Disclosure Statement (including PTO Form 1449A/PTO and copies of references cited thereon);
6. Postcard Receipt;
7. A paper entitled "Amendment" which includes proposed Reissue Claims;
8. Statement Claiming Small Entity Status;
9. A paper entitled "Notice of Litigation;"
10. Copy of U.S. Patent 5,602,905 which has 5 pages of specifications (including abstract, drawings, and detailed description of the invention) and 5 claims; and

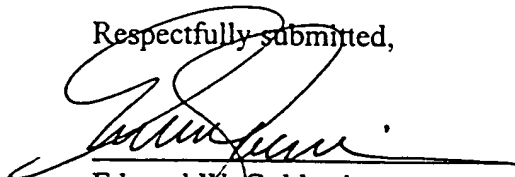
ENCL 2

11. A check in the amount of \$461.00 (filing fee, \$395.00, reissue independent claims over original patent, \$41.00, Abstract of title, \$25.00).

If for any reason the check is missing or insufficient, the Commissioner is authorized to charge any additional fees which may be required (or credit any overpayment) to Deposit Account No. 20-1299; Order No. 6388.005/EWG.

If any additional informalities are identified by the Examiner, please contact the undersigned attorney at (713) 877-1515.

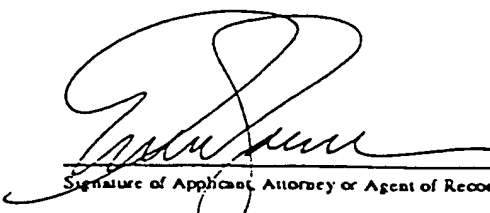
Respectfully submitted,



Edward W. Goldstein  
Reg. No. 22945  
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Houston, TX 77056  
Telephone: 713/877-1515  
Facsimile: 713/877-1145

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\*\*>PTO:SI/36 (6-95)  
Approved for use through 05/31/96. OMB 0651-0033  
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE<

REISSUE APPLICATION FEE DETERMINATION RECORD						Docket Number (Optional) 6388.005		
Claims as Filed - Part 1								
Claims in Patent	For	Number Filed in Reissue Application	(3) Number Extra	Small Entity		Other than a Small Entity		
				Rate	Fee	Rate	Fee	
(A) 5	Total Claims (37 CFR 1.16(i))	(B) 9	**** 0 =	x \$__ =		OR	x \$__ =	
(C) 2	Independent Claims (37 CFR 1.16(f))	(D) 3	* 1 =	x \$41 =	41		x \$__ =	
Basic Fee (37 CFR 1.16(h))					\$395		\$__	
Total Filing Fee					\$436		OR \$	
Claims as Amended - Part 2								
	(1) Claims Remaining After Amendment		(2) Highest Number Previously Paid For	(3) Extra Claims Present	Small Entity		Other than a Small Entity	
					Rate	Fee	Rate	Fee
Total Claims (37 CFR 1.16(j))	***	MINUS	**	=	x \$__ =		OR	x \$__ =
Independent Claims (37 CFR 1.16(f))	***	MINUS	*****	=	x \$__ =			x \$__ =
Total Additional Fee					\$		OR \$	
<p>* If the entry in (D) is less than the entry in (C), Write "0" in column 3.            ** If the "Highest Number of Total Claims Previously Paid For" is less than 20, Write "20" in this space.            *** After any cancellation of claims            **** If "A" is greater than 20, use (B - A); if "A" is 20 or less, use (B - 20).            ***** "Highest Number of Independent Claims Previously Paid For" or Number of Independent Claims in Patent (C).</p> <p><input type="checkbox"/> Please charge Deposit Account No. _____ in the amount of _____. A duplicate copy of this sheet is enclosed.</p> <p><input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any additional fees under 37 CFR 1.16 or 1.17 which may be required, or credit any overpayment to Deposit Account No. <u>20-1299</u>. A duplicate copy of this sheet is enclosed.</p> <p><input checked="" type="checkbox"/> A check in the amount of \$ <u>461.00</u> to cover the filing / additional fee is enclosed.</p>								
<u>8/17/98</u> Date		 Signature of Applicant, Attorney or Agent of Record <u>Edward W. Goldstein</u> Typed or printed name						

\*\*>Burden Hour Statement: This form is estimated to take 5 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.<

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application for Reissue of:	§	
Patent No. 5,602,905	§	
Patentee: RICHARD P. METTKE	§	
Issued: February 11, 1997	§	Attorney Docket No.: 6388.005
For: ON-LINE COMMUNICATION	§	
TERMINAL/APPARATUS	§	
	§	

AMENDMENT

Applicant, Richard P. Mettke, submits the following Amendment.

IN THE CLAIMS

Applicant requests that reissue claims 6-9 be added to the reissue application.

6. A public on-line, pay-as-you-use communications terminal comprising a housing,  
wherein the housing contains:

- a central processing unit (CPU);
- a telephone access node;
- an internal modem coupled to the CPU and telephone access node;
- a video display monitor coupled to the CPU;
- a keyboard for providing user interface coupled to the CPU;
- a credit card reader swipe device coupled to the CPU for accepting payment by a user for use  
of the terminal;
- means for accessing the Internet and allow for user interaction;

software installed into the CPU to allow interface with the Internet and credit card service centers; and

a printer coupled to the CPU.

7. The terminal of claim 6, wherein the means for accessing includes a touch screen interface attached to the monitor and further includes a touch screen means for accepting input information from the touch screen interface and modifying program execution accordingly.

8. The terminal of claim 6, further comprising, within the housing, program means for causing the printer to print a receipt or any other document available from the Internet.

9. The terminal of claim 6, wherein the housing includes a durable enclosure for the CPU, monitor, internal modem and printer, and a secured access door for service and repair.

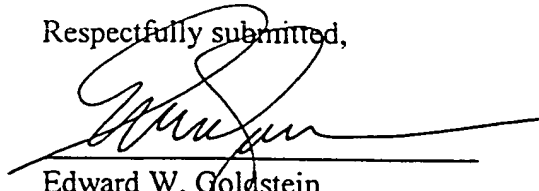
#### REMARKS

Reissue claims 1-9 are pending. Reissue claims 1-5 remain unchanged from claims 1-5 in U.S. Patent No. 5,602,905. Applicant has added reissue claims 6-9. Reissue claims 1-5 are directed to a communications terminal for accessing commercial on-line services such as America On-Line. Reissue claims 6-9 are directed to a communications terminal for accessing the Internet. Reissue claims 6-9 have been submitted because of the differences between commercial on-line services and the Internet as stated by the Examiner during prosecution of the application which issued as U.S. Patent No. 5,602,905. Specifically, the Examiner stated “‘commercial on-line service’ is not

equivalent to "Internet provider." Office Action dated April 27, 1995 in Application Serial No. 08/376,247, page 8. Accordingly, Applicant submits reissue claims 6-9 directed to a communications terminal for accessing the Internet.

Applicant respectfully requests that reissue claims 1-9 be allowed and a Notice of Allowance issued.

Respectfully submitted,



Edward W. Goldstein

Reg. No. 22945

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Houston, TX 77056

Telephone: 713/877-1515

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F:\CLIENT\66388\005\PTO\CLAIMS.REI

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application for Reissue of:	§	
Patent No. 5,602,905	§	
	§	
Patentee: RICHARD P. METTKE	§	
	§	Attorney Docket No.: 6388.005
Issued: February 11, 1997	§	
	§	
For: ON-LINE COMMUNICATION	§	
TERMINAL/APPARATUS	§	
	§	

REISSUE DECLARATION PURSUANT TO 37 C.F.R. §§ 1.63 and 1.175

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

As a below named inventor, I hereby declare:

1. My residence, post office address and citizenship are as stated below next to my name.
2. I believe I am the original, first and sole inventor of the subject matter which is claimed in original Letters Patent No. 5,602,905 granted February 11, 1997, based upon Application Serial No. 376,247 filed January 23, 1995 and to be the original, first and sole inventor of the subject matter of the invention claimed in this application for a reissue patent being filed concurrently herewith.
3. I have reviewed and understand the contents of the specification, including the claims, of this reissue application.
4. I do not know and do not believe that said invention was ever known or used in the United States before my invention thereof.



5. I believe the original patent to be wholly or partly inoperative or invalid by reason of me claiming less than I had the right to claim in the patent because claims directed to my on-line communication terminal/apparatus for accessing the Internet were inadvertently omitted. I prosecuted the application which issued as Letters Patent No. 5,602,905 *pro se*. In the first Office Action, the Examiner objected to the phrase "commercial on-line service/Internet" because it was vague and indefinite as to which limitation defines the scope and breadth of the claim. The Examiner also stated that "commercial on-line services" is not equivalent to "Internet provider." In view of the Examiner's remarks, I mistakenly removed the word "Internet" from the claims without submitting additional claims directed to an on-line communication terminal/apparatus for accessing the Internet. In error, I believed the Examiner's remarks meant that claims directed to accessing the Internet should not be submitted simultaneously with claims directed to accessing commercial on-line services. Accordingly, I mistakenly claimed less than I had a right to claim by not submitting additional claims directed to on-line communication terminal/apparatus for accessing the Internet. The specification certainly provides support for these amendments. For instance, please see col. 2, line 12.

6. The error that may render this patent wholly or partly inoperative arose entirely from inadvertence, accident, and mistake, and without any fraudulent and/or deceptive intent on my part or, on my best information and belief without any fraudulent and/or deceptive intent on the part of anyone else associated with me.

7. The error referred to above is remedied in this reissue application because the new claims in this application, 6-10, specifically recite a public on-line, pay-as-you-use communications terminal for accessing the Internet.

The following identifies all of the claims pending in this reissue application and the differences if any between these amended claims and the original claims of the patent: Original claims 1-5 are directed to a public on-line, pay-as-you-use communications terminal for accessing commercial on-line services and remain unchanged. New claims 6-10 are directed to a public on-line, pay-as-you-use communications terminal for accessing the Internet.

8. I acknowledge the duty to disclose to the Patent and Trademark Office all information, of which I am aware, which is material to patentability of this application as defined in Title 37, Code of Federal Regulations, § 1.56 and at this time bring the following U.S. patents, foreign patents and other publications to the attention of the U.S. Patent and Trademark Office:

U.S. Patents

4,902,881	2/1990 Janku
5,008,928	4/1991 Cleghorn
5,218,633	6/1993 Clagett et. al.
5,247,575	9/1993 Sprague et. al.
5,272,747	12/1993 Meads
5,333,181	7/1994 Biggs
5,393,964	2/1995 Hamilton, et. al.
5,396,546	3/1995 Remillard

The above listing of patents and publications are those that are cited on the face of U.S. Patent 5,602,905.

I also bring to the attention of the U.S. Patent and Trademark Office a copy of the deposition of Daniel J. Toughey, the representative of Touchnet Information Systems, Inc., and copies of the Exhibits attached thereto, a copy of the deposition of John F. Murphy, an employee of Touchnet Information Systems, Inc., a copy of Touchnet Information Systems, Inc.'s Answer to Plaintiff's Interrogatory No. 1, (Marked as Exhibit 2), as well as other documents produced by Touchnet

Information Systems, Inc., all of which Touchnet Information Systems, Inc. alleges invalidates Letters Patent No. 5,602,905:

TouchFax Network Topography Diagram, copyright 1991 (Marked Exhibit 3);

Affidavit of John F. Murphy and letters regarding offers for sale of TouchNet Public Access Terminals dated June 11, 1992 and July 13, 1993 (Marked Exhibit 4);

TouchFax advertisement for public facsimile systems, copyright 1991, (Marked Exhibit 6);

TouchFax advertisement for TF700 Public Communications Terminal (Marked Exhibit 7);

TouchFax advertisement for TF700 Public Communications Terminal, undated, (Marked Exhibit 8);

TouchFax advertisement for TF750 Public Communications Terminal, undated, (Marked Exhibit 9);

TouchFax advertisement for TF400 Public Communications Terminal, copyright 1992, (Marked Exhibit 10);

TouchFax advertisement for TF450 Public Communications Terminal, undated, (Marked Exhibit 11);

Article entitled: TouchFax Provides The Ultimate In Place-Based Interactivity, October 1992, (Marked Exhibit 12);

TouchFax Brochure entitled Multi-Media Interactive Terminal Location Opportunity, undated, (Marked Exhibit 13);

Article entitled TouchFax Keeps ringing Up Public Fax Machine Orders. Kansas City Business Journal, Vol. 11, Number 2, October 2-October 8, 1992, (Marked as Exhibit 14);

TouchFax advertisement entitled The Future Mad Simple. undated, (Marked as Exhibit 15);

Invoices for audio-visual services rendered to TouchFax, May 12, 1993 and May 31, 1993 (Marked as Exhibit 17);

Invoice for audio-visual services rendered to TouchFax, May 24, 1993 (Marked as Exhibit 18);

Invoices for advertising services rendered to TouchFax. September 2, 1993. October 5, 1993, and November 9, 1993 (Marked as Exhibit 19);

Mutual Nondisclosure Agreement. September 2, 1992, (Marked as Exhibit 21);

Letter to TouchFax Information Systems, Inc. from Flying J Inc., September 16, 1992;

National Account Program--Software License Agreement, February, 1993;

National Account Program--Equipment Purchase Agreement, February, 1993;

Facsimile regarding TRIP\_RT and SCANLOAD, dated September 17, 1993;

Facsimile regarding R TRIP Routine Information, dated September 9, 1993;

Various Screen Shots regarding steps taken for Routine Information from Ogden, Utah to Des Moines Iowa, undated;

Invoice for TF450 Public Fax Terminal sold by TouchFax Information Systems, Inc.;

TON Services Estimated Rollout Schedule, June 28, 1993;

TON Services, Inc. Installations as of 5/31/98, including date installed;

Article entitled Airport Kiosk Systems Requirements Statement, August 6, 1992, (Marked as Exhibit 22);

Letter to Dean Vermaire regarding Envoy100 Kiosks, November 5, 1992, (Marked as Exhibit 23);

Letter to Dean Vermaire Logon Script for Envoy100 Access, September 2, 1992, (Marked as Exhibit 24);

Software License Agreement, September 22, 1992, (Marked as Exhibit 25);

U.S. Patent No. 4,359,631 issued to Lockwood, et. al., November 16, 1982 (Marked Exhibit 16).

9. Further, I bring to the attention of the examiner that U.S. Patent 5,602,905 is presently in litigation wherein it has been alleged that my invention was on sale and in public use more than one year prior to the effective filing date of my application, that the claims of U.S. Patent 5,602,905


are obvious under 35 U.S.C. § 103, and that the claims of U.S. Patent 5,602,905 are invalid under 35 U.S.C. § 112. The allegations and documents related to those allegations are described and identified in the Notice of Litigation filed concurrently with this reissue application.

10. I respectfully request that a reissue patent be granted to me for the invention or discovery described and claimed in said Letters Patent and in the foregoing specification and claims, and I subscribe my name to the foregoing petition, specification and claims and declaration and power of attorney.

11. I hereby direct that all correspondence and telephone calls be addressed to Edward W. Goldstein, Tobor & Goldstein, L.L.P., 1360 Post Oak Blvd., Suite 2300, Houston, Texas 77056, (713) 877-1515.

12. I declare further that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application of any patent issuing thereon.

Inventor's Full Name: RICHARD P. METTKE  
(First) (Initial) (Last)

Inventor's Signature: 

Date: 8-13-98 Country of Citizenship: U.S.A.

Residence Address: 620 Shannahan Dr., Weaver, Alabama  
(Include number, street name, city, state, and country)

Post Office Address: 620 Shannahan Dr., Weaver, Alabama  
(Include number, street name, city, state, and country)

TouchFax

# TouchFax Provides The Ultimate In Place-Based Interactivity

By Allen Weiner, Editor



If you think of TouchFax Information Services, Inc., as a company that manufactures public fax machines, you have only part of the picture. In the rapidly growing arena of place-based media, TouchFax is creating products that will allow consumers the same sort of interactive capabilities as they will have with their home-based interactive appliances.

"We believe the information for the machine can be strategically designed for the location type so the type of services and the type of information that can be retrieved interactively on our terminals can be totally different from one machine to another," says John Massey, the machine's creator and chairman of the Lenexa, Kan.-based company.

"We always will have a basic set of common services that are available on all machines," he adds. "But, particular machines will have unique sets of advertisements and promotions on them, as well as related services that relate to the type of people that frequent a particular type of location."

And locations are key to the TouchFax family of products. Massey believes they are best utilized in places where "a number of different types of users can interact with their desired and preferred telecommunications service." Airports, hotels, truck stops, apartment complexes and even supermarkets are ideal for these multifunctional, multimedia machines.

TouchFax hardware products include three models of public terminals used initially as pay-per-use fax machines. They also can provide other services such as word processing and high-quality copies in addition to its primary communications capability of phone, fax and computer. Service products include personal fax mailboxes and information services which may be accessed by TouchFax public terminals and any private fax machines.

The TF Series public terminals are location specific and are designed to meet the space in which they will reside. For example, a lower cost unit designed for lower traffic locations also has a smaller paper storage capacity and would require more frequent service calls if placed in a high traffic location.

All TouchFax terminals use proprietary

software to create an easy-to-use visual control panel. This user interface to the machine is displayed on a touch-sensitive color video monitor which provides instructions to the user and on-screen buttons to operate the terminal functions.

Documents to be sent are scanned on a jam-proof flatbed scanning device which operates much like a standard copy machine. Payment for services is made by using credit card or other magnetic card such as a telephone calling card. The terminal provides a detailed printed receipt of the transaction for expense account record keeping.

**"It's a system that will be deployed nationally and internationally that is designed to be a public terminal, as well as a service that goes into the home."**

TouchFax's TF750 is a free-standing kiosk with a high-resolution, 14-inch color touchscreen monitor, 386 microprocessor, high-volume laser printer, full-size keyboard and data port for modem and laptop connections. The TF450 is a built-in, wall-mounted unit that has an optional floor mount and offers the data ports for modem and laptop connections on an optional basis. The TF200 is a built-in, wall-mounted unit that offers a laser printer as an upgraded feature.

TouchFax offers two service products which adds to its flexibility—a fax mailbox service and electronic library. The TouchFax Mailbox is a centrally managed electronic service capable of storing fax messages. Mailbox subscribers are given a personal phone number to allow fax messages to be sent to their mailboxes, stored in the mailbox and retrieved at any time. To retrieve stored messages, the subscriber calls his mailbox number, enters a Personal Identification Number, enters the fax destination number and the system forwards the stored fax messages as instructed.

The TouchFax Electronic Library is a collection of information products organized by category. These information products are made available by combining information databases and high-resolution fax printer output with the ease of remote telephone communications. Information products are available on TouchFax public terminals and from any private fax machine.

On a TouchFax public terminal, the touchscreen provides an interactive dialog between the consumer and the information provider. For example, a consumer can select OAG FlightFax to get up-to-the-minute flight information, seat availability and fares. The consumer is guided through a series of video screens requesting their specific flight schedule. The TouchFax public terminal then sends the information via computer modem to OAG's database and a one-page personalized report is delivered to the TouchFax terminal by facsimile.

To access the TouchFax Electronic Library from your home or office requires a touch-tone telephone. A user responds to a series of audio prompts and directs the document to his home or office fax machine. For example, consumers can define the content of an up-to-the-minute special interest newsletter compiled from the news resources of *USA Today*.

Users also can request details of forecasters weather conditions in their destination city, maps and directions to specific locations, as well as city guides with suggestions on where to dine and what to see. Other services are oriented specifically toward entertainment and include popular business book summaries, personalized cartoon fax messages and event schedules.

In essence, TouchFax provides the future interactive appliance user a similar service to what he will be able to access with his Interactive Video Data Service terminal, touchscreen telephone or interactive cable device. So, home or away, the consumer can be interactive.

"The TouchFax is designed to emulate exactly what a person will be able to use in their homes," says Massey. "It's a system that will be deployed nationally and internationally that is designed to be a public terminal, as well as a service that goes into the home."

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Leaders see the possibilities before they become obvious. The TF700 is designed with the understanding that the information age is just beginning. It incorporates the latest technology into an integrated system that can meet the communications needs of today and tomorrow.

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Every leader has a great mind. The "mind" of the TF700 is a powerful hardware/software system engineered to provide a comprehensive set of communication functions. TouchNet™ network management software collects usage and billing data, monitors equipment status and uploads documents, software and video screens. This enables operators to remotely manage thousands of TouchFax terminals from one location. The TF700 has the additional power to access other computer systems and enhanced fax services like our own InfoTouch™ electronic library.

## VERSATILITY...

Leaders stay responsive to changing circumstances. The TF700 is a versatile platform that can adapt to take advantage of new technologies and opportunities, while meeting many present needs.

### ~~~~~Public Fax has arrived.

The TF700 is the most complete solution to the needs of the rapidly growing public fax market. It provides high quality fax, jam-free operation and plain paper output in a convenient, self-service terminal.

### -----Information Access is the key.

The TF700's self-instructing touchscreen interface encourages the general public to utilize the many information databases available.

### ~~~~~Word Processing is a plus.

The full-sized keyboard offers the business traveler the perfect solution to composing and printing a letter or even personalizing a greeting card.

### .....Video Advertising works.

The TF700's high-resolution color monitor provides a powerful medium to deliver advertising messages. In addition, each video ad screen can be linked to a printed coupon or sales literature that is instantly printed and delivered at the touch of a button.

**TF**

**THE PUBLIC COMMUNICATIONS TERMINAL  
OF TOMORROW. FOR INDUSTRY LEADERS TODAY.**

*TouchFax*

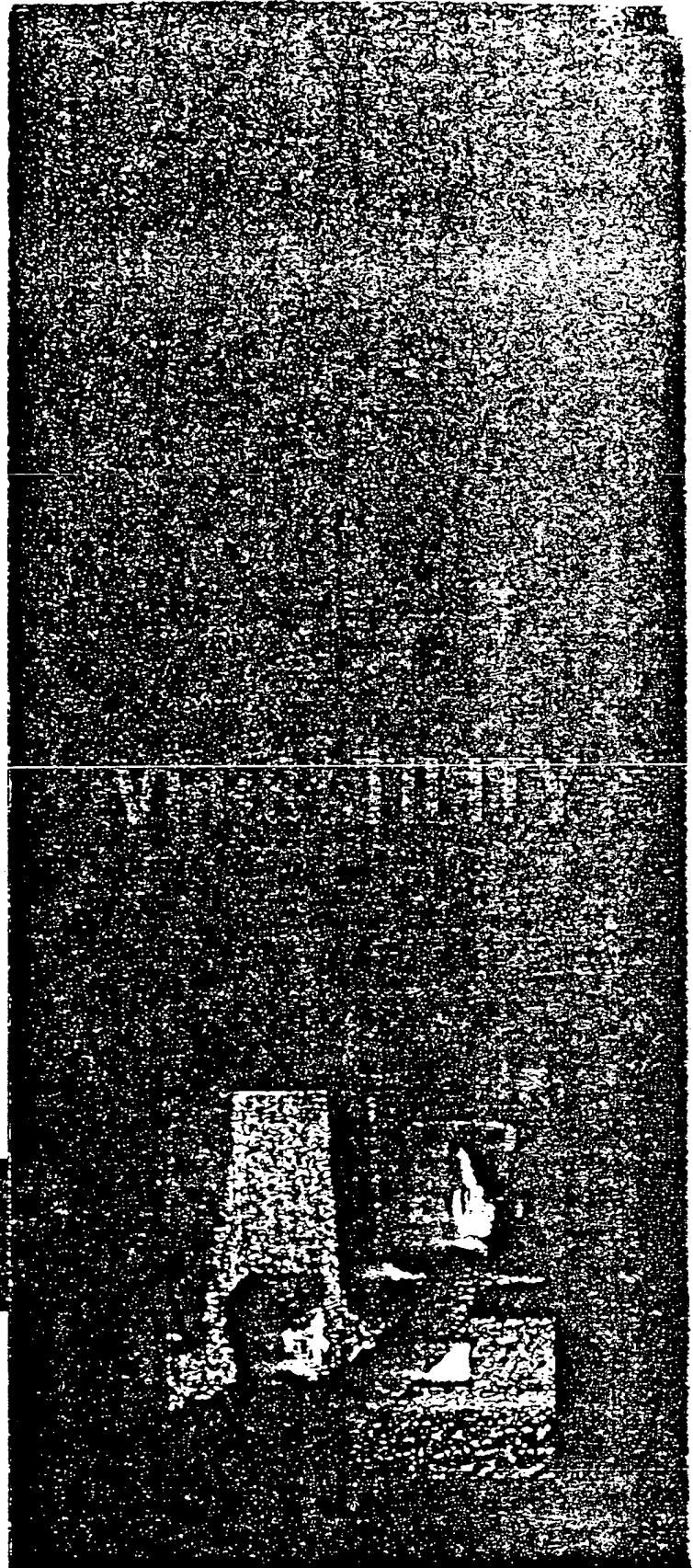
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ENCL #  
4



These are the qualities of an industry leader and qualities built into the new TF700 Public Communications Terminal from TouchFax.

The demand for public communication services is growing. Many of the largest telecommunications companies in the world have seen the handwriting on the wall. Several industry leaders have already responded by selecting TouchFax as their product of choice.

In the new TF700, TouchFax has combined precision engineering and powerful functionality to create the industry's most advanced personal communication center. At the touch of a few buttons, the new TF700 can put anyone in touch with the world through an extensive menu of essential services including:

→ telephone, send or receive a fax, photocopying, word processing and laser printing, and access to a growing network of information databases from Wall Street news to international sports scores.

**Handset and Hookswitch**  
are AT&T quality, delivering high performance and durability.

**External Speaker**  
gives clear audio feedback of busy signals, fax tones, or voice prompts.

**Access Door**  
provides convenient access to internal components, extra paper and supplies.

**Ergonomically Designed Cabinet**  
with heavy-duty steel construction comes in a variety of finishes. Custom colors are available.



**14" Color TouchScreen Monitor**  
offers unrivaled ease of use and displays information and ads in sharp, brilliant colors.

**Credit Card Reader**  
accepts major credit cards, phone cards, and can be programmed to accept custom cards.

**Full-sized Keyboard**  
extends for computer database access or word processing, and retracts when not in use.

**Option Panel**  
allows addition of floppy disk drive, optical card reader, laptop or modem connections.

**300 DPI Flatbed Scanner**  
delivers high resolution with jam-free, photocopier-like operation.

**386 CPU**  
with 40 megabyte hard drive, proprietary control interface and integrated fax and data modem capabilities.

**300 DPI Laser Printer**  
offers crisp, high-resolution printing on plain paper and an optional 700 sheet paper tray.

**Compact Footprint**  
of just 24"W X 28"D lets the TF700 fit in almost anywhere.

TouchFax is a registered trademark © 1991 TouchFax

# Touch

**The Leader in Public Communications Systems**

Now the information age is for everyone. The TF700 provides a friendly, touchscreen window to a universe of information available from on-line computer and fax information services. Never before has the public had easier access to such a wide range of printed information.

"not dated"

# Suggestions for Information Kiosk Systems using the World Wide Web

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*30 April 1994*

## Abstract

Information kiosks provide users with access to community and local information in an easily understandable format. They are designed to be used by the average user who has little or no experience with computer or information systems. Kiosk-based information systems are already available at a variety of locations from airports to shopping malls to community information centers.

The World Wide Web has provided the Internet with an easy interface superceeding other access systems with its popularity and its capabilities. The Web naturally lends itself to a distributed kiosk-based information system although there are special requirements for such a system that current Web clients and servers do not provide.

In this paper we examine the requirements that an information kiosk system based upon the World Wide Web must have before it can be widely accepted as a distributed information system for commercial and non-commercial needs.

## Introduction

A Kiosk-based Information system has many requirements to create the most user-friendly interface while maintaining security and functionality. *User-friendliness* is the most important factor for a public access information system because of the nature of the majority of its customers as non-computer professionals. Other factors that must also be considered for these systems are the functionality and security of the servers.

## The Effectiveness of the World Wide Web as Kiosk-based Information System

The first question that should be asked is why one would use the World Wide Web as a design for a kiosk-based information system. We have identified the reasons why the Web is ideally suited for this application:

- the Web has proven itself as a successful networked information system through its popularity on the Internet.

**EXHIBIT**  
**I**

ENCLOS

- a multimedia tool is the primary type of program used by information systems because of the combination of text, graphics and sound are more appealing. The many different Web browsers have these capabilities already.
- the Web is part of the Internet. This allows users access to the many services on the Internet.
- the ability of the Web to access other programs and services allows programmers to extend the capabilities of the server.
- the Web is a widely accepted standard as opposed to proprietary commercial multimedia systems which holds promise for its growth and development.

## Who will use these systems?

The next question asks who will actually implement and who will use these systems. There has been varied interest by commercial and non-commercial organizations in the World Wide Web. Currently there are several projects underway to develop a commercial version of popular Web browsers as well as commercial services for these browsers.

The following are some examples of who might implement such kiosk-based information systems:

- Commercial, educational and governmental organizations who need to provide in-house information systems about their products and services. For example, hotels, amusement parks, shopping malls, etc.
- Communities and organizations who want to install public access booths to provide community information at key locations within the community, such as community information networks, University campuses, Airport authorities, etc.
- Commercial Information Referral organizations who wish to provide a paid service through such kiosks. *Advertising*



*Pos*

## The Access Interface

The Access Interface comprises both the programs as well as the computer hardware necessary for a kiosk-based information system. This includes the Web browser or client program, the output hardware (the visual display unit, a sound system, printing systems), the input hardware (touch-screen systems, keyboards, light-pens & stylus, keypads, etc.), the kiosk-local processing hardware (if any), kiosk-local cache or information storage (if any), and the network connection hardware.

The user interface or Web browser will be accessed by the average user who may have very little or no experience with computer system. The user interface for a kiosk-based information system should be:

- Easy to use controls. Controls for the kiosk system should be understandable and easy to handle.
- Easy to understand information display. The text or visual information should be easily readable and understood in content and form by the user.
- Access to contents should be as direct as possible. The user should have to go through as few steps as possible for to reach the information they require.
- Documents should be transferred in as short an access time as possible or present a failed message if the time to access the document is longer than a certain amount considered as  $t=\infty$ .
- The program interface should be able to return to a default home page automatically when left idle for an extended period of time.
- The physical unit should be reasonably secure to tampering or vandalism so as not to provide incorrect information.

The following are suggested requirements for an access interface based upon the above suggestions:

### • Physical Requirements

- A minimal number of input devices so as not to confuse the user.
- Easy to use input devices such as a touch-screen or stylus based system
- The unit must be at an adequate height so that it is accessible by most people including handicapped users.
- The output devices should be easy to understand. Visual display output devices should be large enough to be read without difficulty by any type of user. A sound system should be clear enough to be understood but not loud enough to offend.
- Security against vandalism or theft of the kiosk should be maintained.
- A set of clear operating instructions for the booth must be displayed in some form on the physical unit of the booth to ensure proper usage.

### • User Interface Program

- Non-essential items such as buttons or menubars not directly related to the content of each page or not required for the correct usage of the system should not appear. Such items may also give a user access to secure or incomplete areas of the Webspace.
- A common device such as a toolbar should always be present to provide users with a central control mechanism to the interface system. For example, users may wish to return to the home page or skip back to previously viewed pages. This device should be modifiable to the requirements of specific installations.
- Support for internationalization and non-English languages and character sets.
- The program should be able to keep track of the history of documents accessed by the user. It should be able to understand different usage sessions counting each session as one beginning from the home page. It should remove the history of access from previous sessions.
- It may be able to display graphics and movies and play digitized sounds and voice overs.
- It may be able to launch other programs to be presented upon the same output devices.
- There should be a diagnostic mode for servicing the program or the kiosk-local system.

## The Server

There are also suggested requirements for the Server program for these information kiosk systems.

**Commercial organizations will most likely have an invested interest in such information kiosk systems and may require that certain procedures should be followed by the servers for these systems.**

**Note that each kiosk may be a standalone system containing all the local information and with a link to the rest of the network.** This would be a fast but costly system since the information requested the most often would be on local storage media. This may also be difficult to implement and maintain if there is a large amount of data. However, it will reduce the cost of the network link if a non-permanent circuit or dial-up connection is used.

Each kiosk may in turn be a client only system which access the information over the network link from a remote server and caches the information locally. To transfer the information from the server down to the kiosk may take some time but it saves cost and reduces the maintainence. This may be expensive if network connect time charges are expensive.

## Functionality

Functionality of the server is key to its success. The more special functions it serves and the greater the extensibility of the server program, the better its chances of success as a popular system.

The server should be able to access foreign databases which act as storehouses of raw data. The server should be able to locate these databases and the information within with the least amount of processing or translation.

The server should have good support for graphics and graphical enhancements. The concept of imagemaps are almost a must. Mapping between commands and images enhances the ease of use of system. Also useful would be a reverse of the imagemap concept where a user selects an item or enters a piece of text and its corresponding image is displayed.

## Storage and Transfer

Since these kiosks may be located at remote sites, the problems of data storage, caching and transfer becomes important especially considering that the information has to be presented in a rapid and predictable manner.

The problems of data storage are directly related to the actual implementation and hardware requirements of the system. Although no specific suggestions have been made as to the actual computer system required for a kiosk-based information system, the general trend is to use cheaper and cost-effective equipment to reduce the problems of theft, vandalism, or damage.

If the server and data is located locally, the kiosk would only require to use the network when accessing remote documents. The kiosk-local computer system would not require a very large cache area since the documents can be accessed very rapidly.

If the server is located remotely more considerations come into play. The server must be able to respond and transfer documents in a limited amount of time over the network link. Servers might also be able to offload requests to other similar servers when they are too busy to respond. This suggests a form of server to server communication and load-balancing which is currently *not* a part of the HTTP specification. The data may require to be replicated across several storage systems and duplicate servers on other computer systems may be necessary as a failsafe measure to ensure constant access.

## Security

Security of the server depends upon the type of implementation of the kiosk, whether standalone or remote server based. However, certain common elements exist in both, such as physical access to the server's computer system. Access to the console of the server should only be allowed to secure personnel to ensure the safety of the information.

Network security is another issue. Access to the computer network that the servers are located on should be secure to reduce the chance of computer cracking or vandalism of the information. Since most servers run on common operating systems such as UNIX, VMS, etc., operating system security is also a crucial element in the safety of the information.

Data managers should decide upon a protocol for operator access, updating and maintenance of the information since it can affect the lives of many others.

Another form of access is dependent upon the content of the documents. A public system will not often

contain restricted documents but data managers may wish to restrict certain areas of their Webspace dependent upon their own criteria.

## Control

Control involves the access to the server and kiosk system for diagnostic examinations and also modification of the information space. Control is tied in very closely with security.

Operators and Data Managers may wish to log access to documents for statistical analysis. Keeping accurate logs of document access can help administrators anticipate growth of the installation.

Each installation should be able to decide which URI's are accessible through their server. Some installations may decide that they do not wish to provide their kiosks with access to the "news" or "mailto" services.

Commercial organizations may also wish to charge customers for access to specific documents or services. The concept of registered users and billing may be built into the server.

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Mr. Richard P. Mettke

April 6, 2002

Reference: Patent Number: 5,602,905

Dear Mr. Mettke,

Upon complete review of your original patent application (8/376247) and patent number 5,602,905, reissue amendment filed on DEC 11, 2001, and USPTO Office Action dated MAR 12, 2002 (Examiner Woo), I would submit to you the following observations as someone skilled in the art.

**General Observations:** The patent application articulates well a multitude of automation capabilities that one should considered "commonplace" in 1994. Typical home and business computers (Intel based 286/386 and other compatible class processors) were capable of performing all tasks and features described in your background description of prior art. Specifically, those systems were capable of sending and receiving faxes via internal or external modem, generating electronic documents and printing or faxing them to a remote terminal, communicate with on-line service providers (Prodigy, CompuServe, AOL), as well as be used to communicate on the Internet via Internet service provider (ISP). The ability to couple a credit card reading device to a computer terminal was also common place during this time as many point-of-sale devices (i.e. cash registers) were in fact systems built from the core components found inside a computer terminal.

**Understanding and Interpretation:** The most straightforward approach to building the terminal device described in your patent is to use and adapt operating systems, hardware, and software that was readily available. With commercial off the shelf (COTS) hardware and software available in 1994 and the details given in the referenced patent I submit the following comments with regard to the feasibility of building such a terminal device.

Attachment 2

1. The Microsoft Windows 3.1 operating system was released April, 1992 and was the most popular computer operating system on the market in 1994. Windows NT 3.1 was released August 1993. Either operating system could fully support the functionality needed to enable a computer terminal as described in your patent.
2. The ability to print information generated by or downloaded to the computer terminal is a common capability for such a device described in the patent. Operating systems identified in #1 above support a wide variety of laser quality printers, there is no particular challenge to make this feature work.
3. Given that the terminal device must communicate with on-line service providers, Internet service providers, and have the ability to send/receive faxes, it would be highly desirable to have a high-speed internal modem in the terminal. Such devices were readily available and could perform all communications tasks as defined in the patent.
4. Assuming that a Fax/Modem device is installed in the terminal I would point out that the software, which typically accompanies such devices, would fully enable the terminal to perform dial-up connections to on-line services, Internet services, and send/receive electronic faxes.
5. Microsoft Office was release in January 1990 and would provide an array of office automation capabilities on the terminal. Since your patent only identifies word processing I would select the Microsoft Word application, which was available as a separate software package, to provide word processing capabilities at the terminal device.
6. In order for the computer terminal to access on-line service providers (Prodigy, CompuServe, AOL) specialized software would be needed. It was, and still is, commonplace for such service providers to distribute dial-up software free of charge to customers that subscribe to their service. The computer terminal would need one copy of each on-line provider's access software package to properly communicate with their host network. In my experience it was commonplace for multiple on-line provider software packages to reside on a single computer terminal and would not present itself as a technical challenge to configure.



7. The computer terminal would also require specialized software to dial-up and obtain network connectivity from an ISP. As described in your patent this capability would enable the terminal user to send and receive email and locate information available on the Internet. Windows 3.1 and NT 3.1, along with the Internet Explorer web browser (which is part of the operating system) has sufficient dial on demand capabilities to support the task of providing ISP based services.

**Review of Figures:** The functional operation of this proposed terminal device is clearly illustrated in figure 1. It illustrates relationships between the general telephone switching network, on-line service providers, Internet service provider, and the computer terminal device. It further illustrates the functional relationship between the terminal device and a credit card service provider. As figure 1 illustrates, the computer terminal device may require a single plain old telephone system (POTS) circuit to perform credit card validation, dial-up access to on-line and Internet services, and send/receive faxes.

Figure 2 illustrates a physical layout of the computer terminal and cubical or privacy booth that would contain the device(s) identified in figure 1. What is not apparent in either figure, but what I perceive is implied in the patent, is that a housing would be used to store the computer terminal, input/output apparatus, and credit card swiping device. It would be highly desirable to centralize such components in a single enclosure and limit access to the devices through a customer service opening in the front, and a lockable access panel to protect and secure components from tampering and/or theft. Such enclosures were readily available on the market and are frequently used in manufacturing plants, assembly line operations, and in other environments where delicate devices must be protect from damage due to impact, natural elements, and/or vandalism. The computer terminal as described in the patent would easily fit within a single housing and does not present itself as a technical challenge.

**Evaluations of Exhibits:** The following table identifies the features and capabilities listed in or implied within each of the exhibits and the Mettke patent. Upon close

evaluation it is my opinion that none of the three exhibits provide at least the same services as described in the patent or reissue application. The TouchFax exhibits clearly provide a customer with advanced fax, copier, word processing, and proprietary database access to selected information. However, that system does not provide access to existing on-line service providers (i.e. Prodigy, Compuserve, AOL), nor does it suggest that the TouchFax devices have the capacity to offer direct Internet access through an ISP.

The Shah article provides a framework for building information kiosk system using the World Wide Web as it's primary communication and information infrastructure. While it lists and recommends much of the same equipment identified in the patent it clearly does not mention nor imply that such kiosk devices should offer customers access to existing on-line service providers, or the Internet on a point-of-sale basis, or provide pay-per-use send/receive fax service. The Shah article makes no mention of a credit card swipe reader. The following matrix identifies the similarities and differences in capabilities as stated and implied within each exhibit, the patent, and reissue patent.

Feature	Exhibit E TouchFax	Exhibit F TouchFax	Exhibit I "Shaw" Article	Mettke Patent	Mettke Reissue Patent
Access to Internet services			x	x	x
Access to on-line Services				x	
Advertisements and promotions	x	x	x		
Credit Card Reader	x	x		x	x
Data Ports	x	x			
Electronic Library	x	x			
Fax Mail Box Service	x				
Flat Bed Scanner Device	x	x			
High Quality Copier	x	x			
Keyboard	x	x	x	x	x
Laser Printer		x	x	x	x
Light-pen, stylus, keypad			x		
Multi-language support			x		
Network Connection Hardware			x		
Pay-per-use	x	(implied)	x	x	x
Phone	x	x			
Printed Receipt	x			x	x
Remote System Management		x	x		
Send/Receive Fax Services	x	x		x	x
Sound system			x		
Touch Fax Information Service	x	x			
Touch Net		x			
Touch Screen Monitor	x	x	x	x	x
Web Browser			x	(implied)	(implied)
Word Processing	x	x		x	x
See Footnotes:	1,2	3	4	5	


1. Makes vague reference to providing "...related services that relate to the type of people that frequent a particular type of location"
2. Electronic library produces "fax" output only, and on topics made available via proprietary databases (i.e. OAG Flight Fax for flight information)
3. On the bottom of page two, right hand corner, a vague comment is made to the product providing access to "...a universe of information available from On-line computer and fax information services." The nature of this advertisement implies that the on-line services provided are those available through a proprietary library service that the fax device will interact with and produce output from.
4. Makes no mention of kiosks that can access existing on-line service providers or their information (i.e. Prodigy, Compuserve, AOL) or the Internet
5. On-line services are defined in the patent as commercial services such as Prodigy, Compuserve and AOL.

**Conclusion:** Having reviewing the referenced patent and three exhibits I have formed the following professional opinions:

1. Having read and understood information provided in patent 5,602,905 and the reissue amendment it is my firm belief that the pay-per-use fax service, ability to access on-line service providers, and ability to access information on the Internet via ISP is feasible and defined sufficiently enough as to allow someone skilled in the art to build and deploy such a device.
2. Exhibits E and F clearly communicate that their primary capabilities are to provide word processing, copier, and fax services to the patron. These devices have the ability to interact with and retrieve information from a proprietary database, but only to the extent that the service provider has anticipated the needs of their customers and pre-loaded the information as to make it available. These devices clearly lack the ability to communicate or interact with data stores generally found on the Internet through an ISP. Neither do TouchFax devices allow access to existing on-line services, such as Prodigy, Compuserve and AOL or the Internet.
3. The Shah article provides a framework for building information kiosk system using the World Wide Web as it's primary communication and information infrastructure, however it does not state nor imply such devices should offer access to existing on-line service providers, the Internet, or a send/receive fax service on a point-of-sale basis.

**Personal Background and Credentials:** I currently work for the United States Government in the capacity of Acting Directory, Information Management, at Fort Leonard Wood, Missouri 65473. Specific duties and technical skills include Network/System administrator of a 5000 node Campus Area Network composed of Windows and Unix based servers and desktop computers. Programmer, develops software applications using multiple high-level interpreted and compiled languages.

Adjunct Faculty member of Columbia College, Fort Leonard Wood Extended Studies Division, teaching numerous programming, software engineering, networking and data communications courses in the Computer Information Systems and Math department. Owner, VagaTech networking and Internet solution provider business operating in Waynesville, Missouri 65583. Education: Masters degree in Information Resource Management from Webster University, St. Louis Missouri, and an undergraduate degree in Computer Information Systems from Columbia College, Columbia Missouri. Contact Information: I can be reached via email: [greg@vagatech.com](mailto:greg@vagatech.com), phone: (573) 774-2544, or U.S. mail: 22740 Rose Meadow Lane, Waynesville, MO 65583

  
Gregory W. Adank

24 AUG 99

## Office Action Summary

Application No.  
09/134,831Applicant(s)  
MettkeExaminer  
Stella WooGroup Art Unit  
2743
☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-9 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-9 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 8, 11
☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

ENCL?

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### DETAILED ACTION

1. A protest against issuance of a patent based upon this application was filed under 37 CFR 1.291(a) on November 4, 1998 by TouchNet Information Systems, Inc., and a copy has been served on applicant.

A protest against issuance of a patent based upon this application was filed under 37 CFR 1.291(a) on March 31, 1999 by North Communication, Inc. However, this protest did not include a copy of every document relied upon by the protestor, as required by 37 CFR 1.291(b)(3). A supplemental protest was filed April 1, 1999 providing the missing prior art documents. A complete protest, which duplicates the initial protest papers filed March 31, 1999 and the supplemental papers filed April 1, 1999, was filed April 1, 1999 under 37 CFR 1.291(a), and a copy has been served on applicant.

A protest against issuance of a patent based upon this application was filed under 37 CFR 1.291(a) on August 17, 1999 by Griffes Consulting, SA, and a copy has been served on applicant.

The three protests filed November 4, 1998, April 1, 1999, and August 17, 1999 have been considered by the Office as discussed below.

2. Protest filed November 4, 1998 under 37 CFR 1.291(a) by TouchNet Information Systems, Inc.

\* A. Protestor asserts that the Protestor was the first to invent the subject matter taught and claimed in the original patent.

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There is insufficient evidence to support the allegation. The exhibits presented fail to  
show that the Protestor was the *first* to invent the subject matter of the original patent (claims 1-5  
of the present reissue application). Exhibit A shows the disclosure of a U.S. patent application  
✱ S.N. 07/600,712 which was abandoned. Since this application did not successfully result in a  
patent, it is not clear how this demonstrates the Protestor as being the first to invent. The Office  
actions issued during the prosecution of S.N. 07/600,712 (Exhibit I) provide clear reasons why  
the Protestor was not the first to invent, including the citation of the prior art reference of U.S.  
✱ Patent No. 4,359,631 to Lockwood et al. (Exhibit H).

B. Protestor asserts that the Protestor was the first to invent the subject matter taught and  
claimed in the reissue application.

Again, a U.S. patent was not granted for the subject matter disclosed by the Protestor  
such that it has not been established that the Protestor was the *first* to invent the subject matter of  
claims 1-5 of the reissue application. Claims 6-9 of the reissue application recite accessing and  
interfacing with the Internet. Although Exhibit C,4 shows a frame from the video tape of Exhibit  
C advertising connection to the Internet, it was stated in the deposition of Daniel J. Toughey  
(Exhibit K, page 44, lines 10-23) that the terminal shown in the video tape did not actually enable  
a user to gain access to the Internet. None of the other documents show that the Protestor  
✱ invented a public, on-line, pay-as-you-use communications terminal as recited in claims 6-9 of the  
reissue application, specifically, "means for accessing the Internet and allow for user interaction"  
and "software installed...to allow interface with the Internet."



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C. Protestor asserts that the Protestor made public use and offered for sale, for more than one year prior to the date of the original application for patent upon which the present reissue application is based, the subject matter taught and claimed in the original patent and reissue application as demonstrated by the documents attached hereto.

110 ← Exhibits C, D, E, F, and G demonstrate that the Protestor made public use and offered for sale the subject matter claimed in the original patent (claims 1-5 of the present reissue application) and are applied against claims 1-4 under 35 USC 103 and in combination with U.S. Pat. No. 4,359,631 to Lockwood et al. against claim 5 under 35 USC 103 as set forth below.] However, it

is not clear from the documents presented that the [Protestor made public use and offered for sale the subject matter of claims 6-9 in the reissue application, namely, the "means for accessing the Internet and allow for user interaction" and "software installed...to allow interface with the Internet." Although Exhibit C,4 shows a frame from the video tape of Exhibit C advertising connection to the Internet, it was stated in the deposition of Daniel J. Toughey (Exhibit K, page 44, lines 10-23) that the terminal shown in the video tape did not actually enable a user to gain access to the Internet, but merely showed a possibility. The offering for sale of a mere conception of the invention before the critical date is not enough (note MPEP 2133.03(c), section I, A). The

Protestor fails to show that the invention was developed beyond mere conception.

3. Protest filed April 1, 1999 under 37 CFR 1.291(a) by North Communications, Inc.

A. Protestor asserts that claims 1-9 are anticipated by the prior art (Exhibits A2, A6, M).

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Exhibits A2 and A6 are directed to a government kiosk system which receives payment from the user for the purchase of ordered products (e.g., items from the Government Printing Office, stamps-by-mail, EE Bonds; A2, page 37, section (d) and A6, page B36, section (d)) or the payment of fines or filing fees (e.g., motor vehicle registration, traffic fines, tax payment, naturalization request filing fee; A2, page 38, first paragraph and A6, pages B36 through B37). Exhibits A2 and A6 fail to anticipate claims 1-9 because they do not teach receiving payment from the kiosk user for "use of the terminal" (claim 1, lines 26-27; claim 5, lines 17-20; claim 6, lines 8-9). Moreover, since the purpose of the government kiosk system of Exhibits A2 and A6 is to provide electronic access to government information to all the public, guarding "against the risk of creating two societies: the electronic information 'haves' and 'have nots'" (Exhibit A5, page 1), it would defeat this public service goal if a kiosk user were charged for using the terminal. The user is required to pay only for items that normally require payment, such as stamps, traffic fines, and document ordering. The user is not charged for "use of the terminal."

Exhibit M discusses the components and design of a typical kiosk system. Although it discloses a credit card reader and communication with a credit authorization network (page 12, section 5.1.2; page 22, section 6.1), it does not teach receiving the credit card payment for using the terminal. As with Exhibits A2 and A6, Exhibit M discusses credit card payment for a purchased product, such as an airplane ticket (page 2, section 1.2.3), not for "use of the terminal."

Same as Lockwood

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B. Protestor asserts that claims 1-9 are obvious in view of the prior art (Exhibits B and K; B and I; B and L; I with any of C, D, E, F, G, H, or J).

Exhibit B (see Fig. 1) discloses an electronic mail system (10) in which electronic mail messages can be stored or retrieved through standard Automatic Teller Machines (ATMs 22, 24), point-of-sale (POS) terminals (34), or ATM/POS terminals (26, 28) by paying users. However, these terminals do not contain a telephone access node or an internal modem. Rather, they are connected to the existing ATM data communication network (16) and POS data communication network (38) which interconnect with regional and national clearinghouse networks for communicating transaction data. The purpose of the system in Exhibit B is to provide readily accessible public electronic mail communication using standard ATM/POS terminals by linking existing ATM/POS communication systems with an electronic mail system (col. 1, line 50 - col. 2, line 23). Exhibits K, I and L discuss the use of special-purpose information kiosks, not standard ATM/POS terminals which are already interconnected via existing ATM/POS data networks. Exhibit B specifically teaches away from the use of special purpose terminals and promotes the greater functionality of combining the existing ATM/POS networks with an electronic mail system (col. 1, lines 50-57) such that it would not have been obvious to an artisan of ordinary skill at the time of invention to incorporate an internal modem and telephone access node into each ATM/POS terminal to provide the online service.

Exhibits C, D, E, F, G, H, and J are articles describing various special-purpose kiosks for purchasing products or payment of fines, and Exhibit I teaches the desirability of Internet access

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~~X~~ and charging users for access and services. The examiner finds the exhibits relevant to the claimed invention but lacking in sufficient detail as to be applied against the claims in the manner suggested by the protestor. For instance, none of the exhibits specify an internal modem and a telephone access node within the terminal.

~~X~~ C. Protestor asserts that claims 1-5 are anticipated by the TouchFax product as disclosed in the exhibits submitted in the TouchNet Protest filed November 4, 1998. A rejection of claims 1-4 under 35 USC 103 as being unpatentable over the TouchFax product is set forth below, and a rejection of claim 5 under 35 USC 103 as being unpatentable over U.S. Pat. No. 4,359,631 (Lockwood et al.) in view of the TouchFax product. *Same as before*

~~X~~ D. Protestor asserts that new claims 6-9 added in the reissue application are prohibited by 35 USC 251 because they contain new matter, namely, connection to the Internet.

A rejection of claims 6-9 under 35 USC 251 for containing new matter, namely, connection to the Internet, is set forth below. *new material*

~~X~~ Claims 6-9 recite additional subject matter which is not supported by the original disclosure, namely, a "housing" as containing the elements of claims 6-9; the "touch screen interface" of claim 7, lines 1-2; the "touch screen means" of claim 7, line 2; the "durable enclosure" of claim 9, line 1; and the "secured access door" of claim 9, line 2. A rejection of claims 6-9 under 35 USC 112, 1st paragraph is set forth below. *Spec*

*NO  
Amended  
or  
original*

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E. Protestor asserts that the original patent claims carried forth in the reissue application are prohibited by the statute as new matter. A rejection of claims 1-5 under 35 USC 112, 1st paragraph is set forth below. <sup>"wrong"</sup> Spec.

4. Protest filed August 17, 1999 under 37 CFR 1.291(a) by Griffes Consulting, SA.

A. Protestor asserts that claims 1-9 are anticipated by the prior art (Exhibits A and B).

Exhibits A and B describe a TouchFax product, a free-standing public communications kiosk. The TouchFax product was similarly described in exhibits submitted with the TouchNet Protest filed November 4, 1998. A rejection of claims 1-4 under 35 USC 103 as being unpatentable over the TouchFax product as described in Exhibits E and F of the TouchNet protest filed November 4, 1998 and a rejection of claim 5 under 35 USC 103 as being unpatentable over U.S. Pat. No. 4,359,631 (Lockwood et al.) in view of the TouchFax product are set forth below. <sup>unobvious</sup>

Although Exhibit B submitted by Protestor describes ISDN connection, it does not specify software installed to allow interface with the Internet, as recited in claim 6 (The Internet is an interconnected computer network which links many computers over communication lines and to which access is achieved via software installed in a computer.) Although communication with the Internet can take place over ISDN as the communication medium, ISDN connection is not the same as "means for accessing the Internet and allow for user interaction," as recited in claim 6.

B. Protestor asserts that claims 1-9 are rendered obvious by the prior art (Exhibits C and D).

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Although Exhibits C and D appear relevant to the claims, they lack certain elements recited in the claims, such as a printer, a touch screen interface and Internet access. Claims 1-9 are rendered obvious by prior art submitted in the Protest submitted by TouchNet Information Systems, Inc. and the Protest submitted by North Communications, Inc. as set forth below.

5. The drawings are objected to because the original disclosure does not support the showing of the terminal housing as depicted in Figure 2, which was submitted as part of a substitute sheet of drawing during the prosecution of the original patent. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. Figure 2, as originally filed, showed a cubicle with a work area/desk top, privacy wall, chair/stool and a terminal device generally labeled as numeral 2. There is no support in the original disclosure for the terminal housing as incorporating the monitor, keyboard, credit card reader, printer and an access door in the manner depicted in the current Figure 2. Correction is required.

6. Claims 6-9 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

Claim 6, lines 10 and 11, "the Internet."

Claim 8, line 2, "the Internet."

- ⑤ Description of Figure 1
- ⑥ Claim 1
- ⑦ Abstract

- original disclosure
- ① Internet is mentioned in the background
  - ② Internet connectivity is mentioned in the Background
  - ③ Objects and Advantages
  - ④ ~~the claims~~ In the reference numerals in drawings

terminal and housing systems

See page 7

terminal

would be option to someone skilled in the art

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New matter, that is, matter not present in the patent sought to be reissued, is excluded from a reissue application (MPEP 1411.02).

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Quoted  
Article

8. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

te

Original Disclosure

The recitations of a "housing" as containing the elements of claims 1-9; the "touch screen interface" of claim 2, line 2 and claim 7, lines 1-2; the "touch screen means" of claim 2, lines 3-4 and claim 7, line 2; the "durable enclosure" of claim 4, line 2 and claim 9, line 1; the "secured access door" of claim 4, line 3 and claim 9, line 2; and the steps of method claim 5 are not supported by the original disclosure as filed on January 23, 1995.

Take  
out

The above new matter was added as an amendment to the specification during the prosecution of the original patent. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: col. 2, lines 3-7; col. 2, line 53 - col. 3, line 3.

Statement in original (check)

What does she mean by this? Known in prior art?

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Applicant is required to cancel the new matter in the reply to this Office action. ←

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over the article entitled "TouchFax Provides the Ultimate in Place-Based Interactivity" (submitted as Exhibit E in the TouchNet Protest on November 4, 1998, hereinafter "Exhibit E") in view of the TouchFax brochure entitled "Vision, Power, Versatility" (submitted as Exhibit F in the TouchNet Protest on November 4, 1998, hereinafter "Exhibit F").

→ Exhibit E discloses a public on-line, pay-as-you-use communications terminal (TouchFax public terminal; Exhibit E, first page, fifth paragraph) comprising a housing (kiosk housing; Exhibit E, photograph on first page), wherein said housing contains:

a central processing unit (386 microprocessor; Exhibit E, second page, first column, third paragraph, line 3);

a telephone access node (data port; Exhibit E, second page, first column, third paragraph, line 3);

an internal modem (modem; Exhibit E, second page, first column, third paragraph, line 5 and second column, second paragraph, line 11);



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a video display monitor (touch-sensitive color video monitor; Exhibit E, second page, first column, first paragraph and lines 2-3 of the third paragraph);

a keyboard (full-size keyboard; Exhibit E, second page, first column, third paragraph, lines 4-5);

a credit card reader (Exhibit E, second page, first column, second paragraph, lines 4-6);

means for accessing commercial on-line services and allow for user interaction (via touchscreen and computer modem; Exhibit E, second page, second column, second paragraph);

a printer (high-volume laser printer; Exhibit E, second page, first column, third paragraph, line 4).

Exhibit E differs from claim 1 in that it does not explicitly recite software installed into the CPU to allow interaction with commercial on-line service providers and credit card centers.

However, Exhibit F teaches the use of such software installed into the CPU of a TouchFax terminal to carry out its communications functions (Exhibit F, first page, second paragraph) such that it would have been obvious to an artisan of ordinary skill to use such installed software, as described in Exhibit F within the TouchFax terminal of Exhibit E to carry out its communications functions with the commercial on-line service providers and credit card centers.

Regarding claim 2, Exhibit E provides for a touch screen interface and touch screen means for accepting input information (Exhibit E, second page, first column, first and second paragraphs; second page, second column, second paragraph).

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Regarding claim 3, Exhibit E provides for printing a detailed receipt (Exhibit E, second page, first column, second paragraph) or any other document (Exhibit E, second page, second column, second paragraph, lines 9-13).

Regarding claim 4, Exhibit F provides for a durable enclosure (heavy-duty steel cabinet; Exhibit F, second page, left-hand column, "Ergonomically Designed Cabinet") and a secured access door (Exhibit F, second page, left-hand column, "Access Door").

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lockwood et al. (USPN 4,359,631, hereinafter "Lockwood") in view of the article entitled "TouchFax Provides the Ultimate in Place-Based Interactivity" (submitted as Exhibit E in the TouchNet Protest on November 4, 1998, hereinafter "Exhibit E").

Wd Lockwood discloses a method of using a public on-line, pay-as-you-use terminal (self-service terminal 1) to access commercial on-line services (e.g., flight schedules, reservations, ticket purchasing services) comprising the steps (note Figure 9) of:

swiping a credit card through a credit card reader (credit card reader 22; operation of terminal 1 is initiated by customer payment in which payment can be effected either by depositing coins or charging to a credit card account after validation, the approval being received by central processor 30; col. 3, lines 34-38; col. 6, lines 22-33; col. 7, lines 10-13);

in response to input from the user (via keyboard 20) who is responding to a selection of on-line services that are assessable and displayed on a monitor (menu of services is displayed on

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monitor 10; col. 7, lines 13-24) and based on interaction between said user and said main program, controlling switching means (audio communications system; col. 7, lines 47-49) to provide communication between a telephone access node (connection with telephone link; Fig. 8) and a modem (modem 38) with a commercial on-line service (remote site computer 42; col. 7, lines 41-51);

printing with a printer (printer 11) a hard copy of documents (col. 7, lines 51-58);

deactivating (user can select a return to the basic menu display after which the system returns to a standby status if no further selection is made within the next thirty seconds; col. 7, lines 59-62, 34-40).

Lockwood differs from claim 5 in that although it provides for accepting payment for services and includes a printer, it does not specify printing a billing statement. However, Exhibit E teaches the desirability of printing a billing receipt at a public terminal which accepts payment for services for the purpose of record keeping (TouchNet protest, Exhibit E, second page, first column, second paragraph) such that it would have been obvious to an artisan of ordinary skill to incorporate the printing of a billing statement, as taught by Exhibit E, within the method of Lockwood in order to provide the user with a hard copy record of transaction expenses.

12. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the article entitled "TouchFax Provides the Ultimate in Place-Based Interactivity" (submitted as Exhibit E in the TouchNet Protest on November 4, 1998, hereinafter "Exhibit E") in view of an article by

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Rawan Shah entitled "Suggestions for Information Kiosk Systems using the World Wide Web", submitted with the Protest by North Communications, Inc. as Exhibit I (hereinafter "the Shah article").

Exhibit E discloses a public on-line, pay-as-you-use communications terminal (TouchFax public terminal; Exhibit E, first page, fifth paragraph) comprising a housing (kiosk housing; Exhibit E, photograph on first page), wherein said housing contains:

- a central processing unit (386 microprocessor; Exhibit E, second page, first column, third paragraph, line 3);

- a telephone access node (data port; Exhibit E, second page, first column, third paragraph, line 3);

- an internal modem (modem; Exhibit E, second page, first column, third paragraph, line 5 and second column, second paragraph, line 11);

- a video display monitor (touch-sensitive color video monitor; Exhibit E, second page, first column, first paragraph and lines 2-3 of the third paragraph);

- a keyboard (full-size keyboard; Exhibit E, second page, first column, third paragraph, lines 4-5);

- a credit card reader (Exhibit E, second page, first column, second paragraph, lines 4-6);

- means for accessing and allow for user interaction (via touchscreen and computer modem; Exhibit E, second page, second column, second paragraph);

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a printer (high-volume laser printer; Exhibit E, second page, first column, third paragraph, line 4).

Exhibit E differs from claim 6 in that it does not specify means for accessing and software for interfacing with the Internet. However, Exhibit E does allow for accessing and interfacing with a remote service provider via a modem and the Shah article teaches the desirability of providing access to and interaction with the Internet in a kiosk-based information system (pages 1-2, section entitled "The Effectiveness of the World Wide Web as Kiosk-based Information System") via the use of appropriate software (Web browser; page 2, section entitled "The Access Interface," line 2) to provide users with access to the many services on the Internet including a paid service by commercial organizations which charges customers for access to specific services (page 2, section entitled "Who will use these systems?" and page 5, lines 11-12). It would have been obvious to an artisan of ordinary skill to incorporate such means for accessing and software for interfacing with the Internet in a kiosk information system, as taught by the Shah article, within the kiosk information system of Exhibit E in order to provide users with access to the many services available on the Internet.

*Pisto*  
*5/25/95*  
*Article*

Regarding claim 7, Exhibit E provides for a touch screen interface and touch screen means for accepting input information (Exhibit E, second page, first column, first and second paragraphs; second page, second column, second paragraph).

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Regarding claim 8, Exhibit E provides for printing a detailed receipt (Exhibit E, second page, first column, second paragraph) or any other document retrieved from a remote source (Exhibit E, second page, second column, second paragraph, lines 9-13).

Regarding claim 9, Exhibit E provides for a durable enclosure and a secured access door (Exhibit E, photo of housing with front access panel on first page).

**13. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 308-9051, (for formal communications intended for entry)

**Or:**

(703) 305-9508, (for informal or draft communications, please label

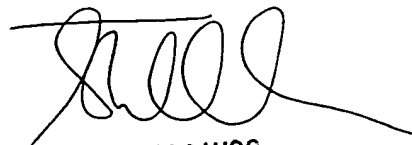
"PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal

Drive, Arlington, VA., Sixth Floor (Receptionist).

**14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella Woo whose telephone number is (703) 305-4395 and can normally be reached Monday - Friday, 6:30 a.m. until 11:30 a.m.**

August 24, 1999

  
STELLA WOO  
PRIMARY EXAMINER



Attorney Docket  
No. 6388.005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
RICHARD P. METTKE )  
)  
)  
Serial No.: 09/134,831 )  
)  
Filed: August 17, 1998 )  
)  
For: ON-LINE COMMUNICATION )  
TERMINAL/APPARATUS )  
)

Group Art Unit: 2743

Examiner: Stella Woo

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AMENDMENT

BOX REISSUE  
Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

<p>CERTIFICATE OF MAILING 37 C.F.R. § 1.8</p> <p>I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: BOX REISSUE, Assistant Commissioner for Patents, Washington, D.C. 20231, on November 22, 1999.</p> <p><i>Stella Woo</i> SIGNATURE</p>
-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------

The following Amendment is in response to the Office Action mailed August 25, 1999 having a shortened statutory period for response set to expire November 25, 1999. This Response is being filed prior to November 25, 1999, and as such, no fees are due. However, in the event that fees are due, the Commissioner is authorized to charge any additional fees which may be required (or credit any overpayment) to Tobor, Goldstein & Healey Account No. 20-1299, Order No. 6388.005/EWG.

Claims 1-9 are pending in the reissue application. Claims 1-9 have been rejected. By this Amendment, claim 5 has been deleted and claims 1-4 and 6-9 have been amended. In view of the

ENCLOS

following amendments and remarks, Applicant respectfully requests allowance of claims 1-4 and 6-9.

#### IN THE SPECIFICATION

At Col. 2, line 53, delete "10" and insert --20--.

At Col. 2, lines 57-58, delete "Numeral 14 generally indicates the printer paper discharge chute".

At Col. 2, line 59, delete "behind the terminals access door".

At Col. 2, lines 61-62, delete "behind the terminals access door. Numeral 17 generally indicates the location of the access door".

#### IN THE CLAIMS

Please delete claim 5.

Please amend claim 1 as follows:

1. A public on-line, pay-as-you-use communications terminal comprising [a housing, wherein the housing contains]:

a central processing unit (CPU);

a telephone access node;

an internal modem coupled to the CPU and telephone access node;

a video display monitor coupled to the CPU;

a keyboard for providing user interface coupled to the CPU;

a credit card reader swipe device coupled to the CPU for accepting payment by a user for use of the terminal;

means for accessing commercial on-line services and allow for user interaction;



software installed into the CPU to allow interface with commercial on-line service providers and credit card service centers; and  
a printer coupled to the CPU.

Please amend claim 2 as follows:

2. The terminal of claim 1, wherein the means for accessing includes a touch [screen interface attached to the monitor and further includes a touch screen means for accepting input information from the touch screen interface and modifying program execution accordingly] terminal which communicates and controls a microprocessor.

Please amend claim 3 as follows:

3. The terminal in accordance with claim 1 also including[, within said housing,] program means for causing said printer to print a receipt or another document available from a commercial on-line service.

Please amend claim 4 as follows:

4. The terminal of claim 1[, wherein the housing includes] further including a durable enclosure for the CPU, monitor, internal modem and printer[, and a secured access door for service and repair].

Please amend claim 6 as follows:

6. A public on-line, pay-as-you-use communications terminal comprising [a housing,

wherein the housing contains]:

a central processing unit (CPU);

a telephone access node;

an internal modem coupled to the CPU and telephone access node;

a video display monitor coupled to the CPU;

a keyboard for providing user interface coupled to the CPU;

a credit card reader swipe device coupled to the CPU for accepting payment by a user for use

of the terminal;

means for accessing the Internet and allow for user interaction;

software installed into the CPU to allow interface with the Internet and credit card service centers; and

a printer coupled to the CPU.

Please amend claim 7 as follows:

7. The terminal of claim 6, wherein the means for accessing includes a touch [screen interface attached to the monitor and further includes a touch screen means for accepting input information from the touch screen interface and modifying program execution accordingly] terminal which communicates and controls a microprocessor.

Please amend claim 8 as follows:

8. The terminal in accordance with claim 6 also including[, within said housing,] program means for causing said printer to print a receipt or any other document available from a

commercial on-line service.

Please amend claim 9 as follows:

9. The terminal of claim 6[, wherein the housing includes] further including a durable enclosure for the CPU, monitor, internal modem and printer[, and a secured access door for service and repair].

### **REMARKS**

#### **I. Protests**

Applicant acknowledges the receipt of the three protests filed November 4, 1998, April 1, 1999 and August 17, 1999. With respect to the issues raised by the protests, Applicant acknowledges that the Examiner relied upon some materials and/or arguments in the protests, and rejected others, in issuing the Office Action. Applicant's responses to the Examiner's rejections of claims 1-9 based upon any materials or arguments made in the protests are found in the following sections addressing the Examiner's rejections.

#### **II. Drawings**

The Examiner has objected to the drawings on the alleged grounds that the original disclosure does not support the showing of the terminal housing as depicted in Figure 2, which was submitted as part of a substitute sheet of Figure 2 during the prosecution of the original patent. Applicant respectfully disagrees with the Examiner's objection because the substitute drawing of Figure 2 does not constitute new matter.

Figure 2 shows one embodiment of the Applicant's claimed invention. Specifically, Figure 2 shows a housing 10 for the terminal, a monitor 11, a credit card swipe reader 12, keyboard 13, printer paper discharge chute 14, the location 15 of the printer, the location 16 of the CPU with internal modem, and the access door 17. Applicant has amended the specification to remove the references to "printer paper discharge chute" and the "access door" and has submitted a substitute drawing of Figure 2 removing these structures and their corresponding reference numerals. The other structures shown in Figure 2 are found in the disclosure as originally filed on January 23, 1995, and/or one or more of the patents listed at Col. 1, lines 36-56.

A durable enclosure, or housing, for a computer and computer circuits is disclosed in U.S. Patent No. 4,092,527 at Col. 2, lines 66-68; Col. 3, line 3; Col. 3, lines 34-38 and in U.S. Patent No. 5,235,680 at Figures 3 and 4. A monitor for a computer terminal is disclosed at page 5 of the disclosure as originally filed, as well as in U.S. Patent No. 4,274,081 at Figure 1 and Col. 2, lines 27-28. A credit card swipe reader for a computer terminal is disclosed at page 5 of the disclosure as originally filed, as well as in U.S. Patent No. 5,334,823 entitled "Systems and Methods for Operating Data Card Terminals for Transaction Chargeback Protection." A keyboard for a computer terminal is disclosed at page 5 of the disclosure as originally filed, as well as in U.S. Patent No. 4,274,081 at Figure 1 and Col. 2, line 28. A printer for a computer terminal is disclosed at page 5 of the disclosure as originally filed. A CPU with internal modem for a computer terminal is disclosed at page 5 of the disclosure as originally filed. Moreover, all of these structures are reasonably communicated to persons skilled in the art in the disclosure such to enable those skilled in the art to make and use the invention as of January 23, 1995. As discussed in the disclosure as filed, "[i]nterconnection and operability of the components is not discussed in greater detail since

the technology is well known in [the] prior art.” Col. 3, lines 1-3. Therefore, Applicant respectfully submits that Figure 2 does not constitute new matter and respectfully requests that the objection to Figure 2 be withdrawn.

### **III. Claim Rejections - 35 U.S.C. § 251**

#### **A. The Examiner’s Rejections**

Claims 6-9 have been rejected under 35 U.S.C. § 251 as being based upon new matter added to the patent for which reissue is sought. The Examiner has stated that the added material which is not supported by the prior patent is “the Internet.”

#### **B. Response To Rejections**

Information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter. As originally filed on January 23, 1995, the disclosure of the application discussed “the Internet” no less than nine times. See pages 2, 4-8 of the original disclosure filed January 23, 1995. The words “the Internet” also remained in that application after several of the uses of the term were erroneously deleted by amendment during the original prosecution. Col. 2, line 12; Col. 2, line 50; Declaration of Richard P. Mettke previously filed with this reissue application. Therefore, ample support exists in the disclosure as originally filed on January 23, 1995 such that the term “the Internet” is not new matter. Accordingly, Applicant respectfully requests that the Examiner’s rejection under 35 U.S.C. § 251 be withdrawn.

#### **IV. Claim Rejections - 35 U.S.C. § 112**

##### **A. The Examiner's Rejections**

Claims 1-9 have been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The Examiner states that the terms "housing," "touch screen interface," "touch screen means," "durable enclosure," "secured access door," and the steps of the method claim 5 are not supported by the original disclosure filed on January 23, 1995.

##### **B. Response To Rejections**

###### **1. Claims Are Supported by Original Disclosure**

Claim 5 has been deleted and claims 1, 2, 6, and 7 have been amended to remove the language objected to by the Examiner. Support for the amendment of claims 2 and 7 is found at Col. 1, lines 43-44.

With respect to claims 4 and 9, the term "durable enclosure" is supported by the disclosure as originally filed on January 23, 1995. As discussed above in connection with the Examiner's objection to Figure 2, a durable enclosure is disclosed in U.S. Patent No. 4,092,527 at Col. 2, lines 66-68; Col. 3, line 3; Col. 3, lines 34-38 and in U.S. Patent No. 5,235,680 at Figures 3 and 4. These patents are specifically identified in the disclosure as originally filed on January 23, 1995. Moreover, a person skilled in the art on January 23, 1995 was fully aware of the use of a durable enclosure in connection with computer terminals. Accordingly, the term "durable enclosure" is not new matter. Therefore, Applicant respectfully requests that the rejections of claims 1-4 and 6-9 under 35 U.S.C. § 112, first paragraph, be withdrawn.

## **2. Specification Does Not Contain New Matter**

With respect to the language added to the disclosure by amendment during prosecution of application 08/376,247 (Col. 2, lines 3-7; Col. 2 line 53 - Col. 3, line 3), Applicant has amended the specification by deleting any reference to the “printer paper discharge chute” and the “access door.” Applicant respectfully submits that the remaining language in Col. 2, lines 3-7 and Col. 2, line 53 - Col. 3, line 3, does not constitute new matter for the reasons discussed above, as well as the reasons discussed in connection with the Examiner’s objection to Figure 2. As discussed above, Applicant submits herewith a substitute drawing page for Figure 2 removing the printer paper discharge chute and the access door. Applicant notes that Figure 2 has been further corrected by changing the reference number “10” to --20-- because Figure 1 already includes the reference numeral 10 for a structure that is different from the structure referred to in Figure 2. Upon the issuance of a Notice of Allowance, Applicant will submit a new formal drawing of Figure 2.

## **IV. Claim Rejections - 35 U.S.C. § 103(a)**

### **A. The Examiner’s Rejections**

Claims 1-4 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the article entitled “TouchFax Provides the Ultimate in Place-Based Interactivity” (hereafter “Exhibit E” for consistency with the Office Action) in view of the TouchFax brochure entitled “Vision, Power, Versatility” (hereinafter “Exhibit F” for consistency with the Office Action).

Claim 5 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Lockwood et al. in view of the Exhibit E.

Claims 6-9 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Exhibit

E in view of an article by Rawn Shah entitled “Suggestions for Information Kiosk Systems using the World Wide Web” (“Shah Article”).

## **B. Response To Rejections**

The PTO has the burden under § 103 to establish a *prima facie* case of obviousness. *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993); *In re Lowry*, 32 F.3d 1579 (Fed. Cir. 1994) (“If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.”)

A PTO rejection for obviousness is improper when there is nothing in the cited prior art references, either singularly or in combination, to suggest the desirability of the claimed subject matter. *In re Deminski*, 796 F.2d 436 (Fed. Cir. 1986). That the construction in a particular prior art reference would have resulted in the claimed combination had it followed the “common practice” of attaching certain parts does not show obviousness at the time of the invention but rather reflects improper hindsight analysis and the reading into the art of the applicant’s own teachings. *Id.* Moreover, combination of one or more references requires a finding on the part of the PTO of a teaching or suggestion, i.e., motivation, to combine the references. *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988); *In re Deminski*, 796 F.2d 436 (Fed. Cir. 1986). Failure to identify any motivation results in a failure to show a *prima facie* case of



obviousness. *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993); *In re Lowry*, 32 F.3d 1579 (Fed. Cir. 1994); *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Claims 1-4 and 6-9 are patentable over all of the references cited by the Examiner in the Office Action. None of the references cited by the Examiner discloses, teaches or suggests a pay-as-you-use computer terminal providing access to commercial on-line services or the Internet as claimed by Applicant. Further, the Examiner has failed to identify any motivation to combine Exhibit E with Exhibit F or to combine Exhibit E with the Shah Article. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness of claims 1-4 and 6-9.

With respect to claims 1-4, Applicant submits that Exhibit E is not proper prior art. A reference is proven to be a "printed publication" "upon satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it." *In re Wyer*, 655 F.2d 221, 10 (CCPA 1981); MPEP § 2128. Accordingly, a level of public accessibility is required. MPEP § 2128.01. One example of accessibility is indexing and cataloging printed material. *Id.* A date of publication, i.e., the date the printed matter was first accessible to the public, is also required. MPEP § 2128.02. While the date of publication may be shown through evidence of routine business practices (*Id.*), failure to provide sufficient evidence to prove the date of publication results in the disqualification of the printed matter as prior art.

Exhibit E appears to be an article in the October 1992 journal entitled "Interactive World." The only evidence of this is provided on the face of Exhibit E. Applicant has been unable to determine where to access "Interactive World," or what individuals had access to Exhibit E at any time prior to the filing date of this application, i.e., January 23, 1995. A representative of the

undersigned attorney searched the catalogues of Rice University and the University of Houston, two of the largest library collections in the fourth largest city in the United States and was unable to locate any journal entitled "Interactive World." Results of the searches are attached hereto as Response Exhibit 1. Because no other evidence has been provided by any of the Protestors, or by the Examiner, that Exhibit E was indexed or cataloged such that it was accessible to the public, and Applicant has presented evidence that Exhibit E was not accessible to the public through Rice University or the University of Houston, Applicant submits that Exhibit E is not prior art that can be cited against the claims of this application.

Assuming *arguendo* that Exhibit E is proper prior art, Exhibit E fails to disclose, teach or suggest linking the facsimile kiosk of Exhibit E with commercial on-line service providers. Exhibit E never discusses commercial on-line service providers. Exhibit E is directed to a facsimile kiosk for sending and receiving facsimile transmissions. Exhibit E does suggest that the kiosk may be used to access "information databases," but only in the context of receiving facsimile transmissions from these databases. Exhibit E, page 2, column 2, paragraph 1, lines 3-7. Accordingly, Exhibit E lacks at least the limitation that the terminal include "means for accessing *commercial on-line services*" in claims 1-4. (emphasis added).

Exhibit F is likewise not proper prior art. No evidence has been provided by any of the Protestors or the Examiner as to where Exhibit F can be accessed by the public, or on what date Exhibit F became accessible to the public. Exhibit F may not have been disseminated to anyone outside of Protestor's organization at any time prior to January 23, 1995. Without sufficient evidence to prove (1) whether Exhibit F was ever accessible to the public; and (2) if it was accessible to the public, on what date was it accessible, Exhibit F can not be considered as prior art to the

application.

Assuming, *arguendo*, that Exhibit F is proper prior art, Exhibit F fails to disclose, teach or suggest software installed into the CPU to allow interface with commercial on-line service providers and credit card service centers. Exhibit F simply includes the word “software.” Nothing else is discussed about the function(s) this software performs. Furthermore, nothing in Exhibit F discloses, teaches, suggests, or even hints, that the facsimile kiosk is interconnected with commercial on-line services. Accordingly, no person ordinarily skilled in the art would view Exhibit F as teaching to install software into the facsimile kiosk to interface with commercial on-line service providers as recited in claims 1-4. In view of the above remarks and amendments, Applicant respectfully requests that the rejections of claims 1-4 under 35 U.S.C. § 103(a) be withdrawn and claims 1-4 be allowed.

With respect to claim 5, Applicant has deleted that claim. Therefore, the rejection of claim 5 is no longer appropriate.

With respect to claims 6-9, Applicant submits that Exhibit E is not proper prior art for the same reasons discussed above that Exhibit E is not proper prior art with respect to claims 1-4.

Assuming *arguendo* that Exhibit E is proper prior art, Exhibit E fails to disclose, teach or suggest linking the facsimile kiosk disclosed in Exhibit E with the Internet. Exhibit E never discusses the Internet. Exhibit E is directed to a facsimile kiosk for sending and receiving facsimile transmissions. Exhibit E does suggest that the kiosk may be used to access “information databases,” but only in the context of receiving facsimile transmissions from these databases. Exhibit E, page 2, column 2, paragraph 1, lines 3-7. Accordingly, Exhibit E lacks at least the limitation that the terminal include “means for accessing *the Internet*” in claims 1-4. (emphasis added).

Like Exhibit E, the Shah Article is also not proper prior art. Neither the Examiner nor the

Protestors has provided any evidence that the Shah Article was accessible to a member of the public exercising reasonable diligence. The Shah Article is only located on the World Wide Web. There is no evidence that the Shah Article is indexed or catalogued in any library or other location accessible to the public. A person skilled in the art would have to know the name of the author, Rawn Shah, to have any chance of locating the article using a search engine on the World Wide Web because the other key terms, e.g., kiosk and Internet, are too generic and would likely result in over 1000 hits. Knowledge of the author of an article, when searching for certain topics, is rarely, if ever, available to the searcher. Therefore, in view of the above remarks, the Shah Article is not prior art properly available to be cited as a basis for rejection claims 6-9 of the application.

Assuming, *arguendo*, that the Shah Article is proper prior art, the Shah Article does not teach the use of any software for interfacing with credit card service centers. There is no discussion anywhere in the Shah Article regarding how a user of the kiosks in the Shah Article would pay for the use of the kiosks. The Examiner erroneously relies upon the statements at page 2, section entitled "Who will use these systems?" and page 5, lines 11-12 for the proposition that the users will pay for access to the Internet through commercial organizations which charge customers for access to specific services. The Shah article never discusses how the user pays for those services. Contrary to the Examiner's citation of pages 3 and 5 of the Shah Article, the commercial organizations' role with the kiosks is as an owner of the kiosk who charges users for the time they use the kiosk. The Shah Article does not discuss the commercial organizations as providing any specific services, let alone charging for Internet access. Further, nothing is disclosed in the Shah Article regarding how these commercial organizations will be paid, let alone, the payment by credit card, at the physical location of the kiosk, utilizing software for interfacing with credit card service centers as recited in

claims 6-9. Accordingly, in view of the above remarks and amendments, Applicant respectfully submits that claims 6-9 are allowable.

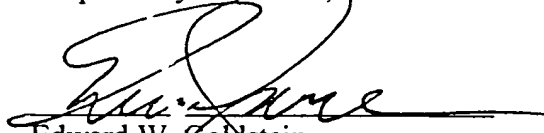
Because every element in the independent claims is not disclosed, taught or suggested in the references cited by the Examiner, rejection under 35 U.S.C. § 103(a) is improper. Therefore, Applicants respectfully request that the rejection of claims 1-4 and 6-9 under 35 U.S.C. § 103(a) be withdrawn.

### CONCLUSION

In view of the above amendments and remarks, Applicant respectfully requests withdrawal of the rejections and allowance of claims 1-4 and 6-9.

Date: 11/22/99

Respectfully submitted,



Edward W. Goldstein  
Reg. No. 22,945

**TOBOR, GOLDSTEIN & HEALEY, L.L.P.**  
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Attorneys for Applicant

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BROWSE**☐ Browse ☒ Keyword

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Technology Center 2600

**SEARCH  
EVERYTHING****AUTHOR****TITLE****PERIODICAL  
TITLE****SUBJECT****SERIES****Basic Search Instructions:**

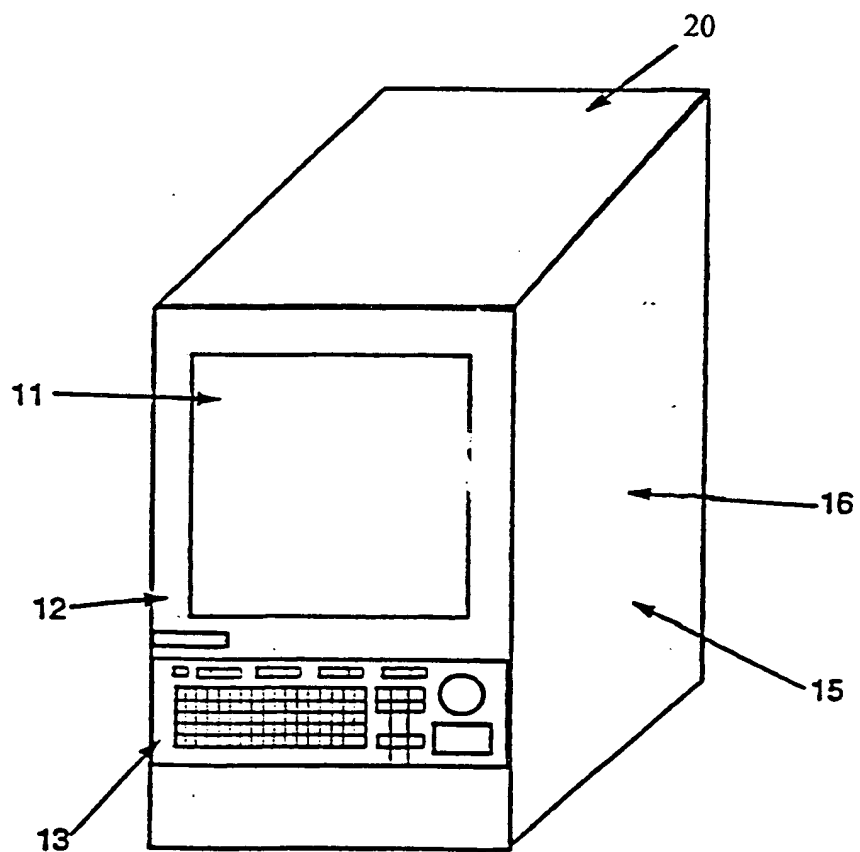
1. Select type of search.
  - **BROWSE** returns an alphabetical list of records *beginning* with the first word entered.
  - **KEYWORD** returns records *containing* the word(s) entered.
2. Enter the word(s) you want to find
3. Choose a search field.
  - **SEARCH EVERYTHING** looks in subject headings for **BROWSE**.
  - **SEARCH EVERYTHING** looks in all parts of a record for **KEYWORD**.
  - All other choices look in specific fields within a record.

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Figure 2





UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
Washington, D.C. 20231  
www.uspto.gov

Paper No. 17

Edward W. Goldstein  
Tobor, Goldstein & Healey, L.L.P.  
1177 West Loop South  
10th Floor  
Houston, TX 77027

**MAILED**

**MAR 13 2001**

**Technology Center 2600**

In re Application of :  
Richard P. Mettke  
Application No. 09/134,831  
Filed: August 17, 1998  
For: ON-LINE COMMUNICATION  
TERMINAL/APPARATUS

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**DEC 06 2002**

**Technology Center 2600**

DECISION ON PETITION TO  
WITHDRAW HOLDING OF  
ABANDONMENT

This is a decision on the petition filed April 17, 2000, to withdraw the holding of abandonment of the above-identified application.

The application was held abandoned for failure to respond in a timely manner to the nonfinal Office action mailed on August 25, 1999. A Notice of Abandonment was mailed on April 4, 2000.

Petitioner asserts that a proper response was in fact timely filed in the form of an amendment. In support of the petition, petitioner submitted a copy of a date-stamped post card receipt acknowledging receipt of the amendment in the United States Patent and Trademark Office on November 29, 1999. Petitioner submitted a copy of the amendment with the present petition.

The original response is not of record in the file and cannot be located. However, M.P.E.P. § 503 states, "[a] post card receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO." Accordingly, it is concluded that the amendment was received in the Office but were not matched with the application file.

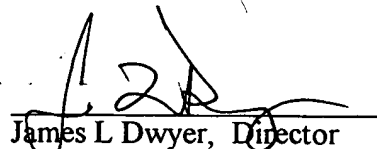
The date-stamped on the post card of November 29, 1999, is after the due date for the response. However, under 37 C.F.R. § 1.8(a)(1) correspondence is considered timely if: (1) the correspondence is mailed or transmitted prior to expiration of the set period for response by being properly addressed to the Patent and Trademark Office as set out in 37 C.F.R. § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail or transmitted to the Patent and Trademark Office in accordance with 37 C.F.R. § 1.6(d); and (2) the correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have a reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

ENCLOSURE

The amendment bears a proper certificate of mailing date of November 22, 1999 in compliance with the requirements of 37 C.F.R. § 1.8(a)(1) as set forth above. Accordingly, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

The petition is **GRANTED**.

The application file will be forwarded to the Technology Center's technical support staff for entry of the amendment. Thereafter, the application file will be forwarded to the examiner for action in due course.




James L Dwyer, Director  
Technology Center 2600  
Communications

6-8-01



## Office Action Summary

Application No. 09/134,831	Applicant(s) Mettke	
Examiner Stella Woo	Art Unit 2643	

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

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## Status

1) ☒ Responsive to communication(s) filed on Apr 17, 2000

Technology Center 2600

2a) ☐ This action is FINAL.2b) ☒ This action is non-final.3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-4 and 6-9 is/are pending in the applica

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from considera

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.6) ☒ Claim(s) 1-4 and 6-9 is/are rejected.7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirem

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).a) ☐ All b) ☐ Some\* c) ☐ None of:

- 1. ☐ Certified copies of the priority documents have been received.
- 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

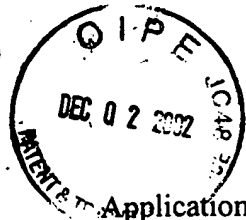
\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other

ENC 10



Application/Control Number: 09/134,831

Page 2

Art Unit: 2643

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to because the original disclosure does not support the showing of the terminal housing as depicted in Figure 2, which was submitted as part of a substitute sheet of drawing during the prosecution of the original patent. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. Figure 2, as originally filed, showed a cubicle with a work area/desk top, privacy wall, chair/stool and a terminal device generally labeled as numeral 2. There is no support in the original disclosure for the terminal housing as incorporating the monitor, keyboard, credit card reader, printer and an access door in the manner depicted in the current Figure 2. Correction is required.

2. The proposed substitute sheet of drawings (substitute Figure 2), filed on April 17, 2000 has been disapproved because it introduces new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of a housing incorporating a monitor, keyboard, and credit card swipe device such that the substitute Figure 2 does not remedy the objection to the drawings given in the last Office action and repeated above.

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***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 2, 4, 7, and 9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

The recitations of a “touch terminal” of claim 2, lines 1-3 and claim 7, lines 1-3; and the “durable enclosure for the CPU, monitor, internal modem and printer” of claim 4, lines 1-2 and claim 9, lines 1-2 are not supported by the original disclosure as filed on January 23, 1995.

The above new matter was added as an amendment to the specification during the prosecution of the original patent. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: col. 2, lines 3-7; col. 2, line 53 - col. 3, line 3.

Applicant is required to cancel the new matter in the reply to this Office action.

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***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over the article entitled "TouchFax Provides the Ultimate in Place-Based Interactivity" (submitted as Exhibit E in the TouchNet Protest on November 4, 1998, hereinafter "Exhibit E") in view of the TouchFax brochure entitled "Vision, Power, Versatility" (submitted as Exhibit F in the TouchNet Protest on November 4, 1998, hereinafter "Exhibit F") for the same reasons given in the last Office action and repeated below.

Exhibit E discloses a public on-line, pay-as-you-use communications terminal (TouchFax public terminal; Exhibit E, first page, fifth paragraph) comprising:

a central processing unit (386 microprocessor; Exhibit E, second page, first column, third paragraph, line 3);

a telephone access node (data port; Exhibit E, second page, first column, third paragraph, line 3);

an internal modem (modem; Exhibit E, second page, first column, third paragraph, line 5 and second column, second paragraph, line 11);

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a video display monitor (touch-sensitive color video monitor; Exhibit E, second page, first column, first paragraph and lines 2-3 of the third paragraph);

a keyboard (full-size keyboard; Exhibit E, second page, first column, third paragraph, lines 4-5);

a credit card reader (Exhibit E, second page, first column, second paragraph, lines 4-6);  
means for accessing commercial on-line services and allow for user interaction (via touchscreen and computer modem; Exhibit E, second page, second column, second paragraph);

a printer (high-volume laser printer; Exhibit E, second page, first column, third paragraph, line 4).

Exhibit E differs from claim 1 in that it does not *explicitly* recite software installed into the CPU to allow interaction with commercial on-line service providers and credit card centers. However, Exhibit F teaches the use of such software installed into the CPU of a TouchFax terminal to carry out its communications functions (Exhibit F, first page, second paragraph) such that it would have been obvious to an artisan of ordinary skill to use such installed software, as described in Exhibit F within the TouchFax terminal of Exhibit E to carry out its communications functions with the commercial on-line service providers and credit card centers.

Regarding claim 2, Exhibit E provides for a touch screen interface and touch screen means for accepting input information (Exhibit E, second page, first column, first and second paragraphs; second page, second column, second paragraph).



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Regarding claim 3, Exhibit E provides for printing a detailed receipt (Exhibit E, second page, first column, second paragraph) or any other document (Exhibit E, second page, second column, second paragraph, lines 9-13).

Regarding claim 4, Exhibit F provides for a durable enclosure (heavy-duty steel cabinet; Exhibit F, second page, left-hand column, "Ergonomically Designed Cabinet").

7. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the article entitled "TouchFax Provides the Ultimate in Place-Based Interactivity" (submitted as Exhibit E in the TouchNet Protest on November 4, 1998, hereinafter "Exhibit E") in view of the TouchFax brochure entitled "Vision, Power, Versatility" (submitted as Exhibit F in the TouchNet Protest on November 4, 1998, hereinafter "Exhibit F"), as applied to claims 1-4 above, and further in view of an article by Rawn Shah entitled "Suggestions for Information Kiosk Systems using the World Wide Web", submitted with the Protest by North Communications, Inc. as Exhibit I (hereinafter "the Shah article").

Exhibit E discloses a public on-line, pay-as-you-use communications terminal (TouchFax public terminal; Exhibit E, first page, fifth paragraph) comprising:

a central processing unit (386 microprocessor; Exhibit E, second page, first column, third paragraph, line 3);

a telephone access node (data port; Exhibit E, second page, first column, third paragraph, line 3);

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an internal modem (modem; Exhibit E, second page, first column, third paragraph, line 5 and second column, second paragraph, line 11);

a video display monitor (touch-sensitive color video monitor; Exhibit E, second page, first column, first paragraph and lines 2-3 of the third paragraph);

a keyboard (full-size keyboard; Exhibit E, second page, first column, third paragraph, lines 4-5);

a credit card reader (Exhibit E, second page, first column, second paragraph, lines 4-6);  
means for accessing and allow for user interaction (via touchscreen and computer modem; Exhibit E, second page, second column, second paragraph);

a printer (high-volume laser printer; Exhibit E, second page, first column, third paragraph, line 4).

Exhibit E differs from claim 6 in that it does not *explicitly* recite software installed into the CPU to allow interaction with credit card centers. However, Exhibit F teaches the use of such software installed into the CPU of a TouchFax terminal to carry out its communications functions (Exhibit F, first page, second paragraph) such that it would have been obvious to an artisan of ordinary skill to use such installed software, as described in Exhibit F within the TouchFax terminal of Exhibit E to carry out its communications functions with the credit card centers in order to authorize payments made via the credit card reader.

The combination of Exhibits E and F differs from claim 6 in that it does not specify accessing and interfacing with the Internet. However, the combination does allow for accessing

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and interfacing with a remote service provider via a modem and the Shah article teaches the desirability of providing access to and interaction with the Internet in a kiosk-based information system (pages 1-2, section entitled "The Effectiveness of the World Wide Web as Kiosk-based Information System") via the use of appropriate software (Web browser; page 2, section entitled "The Access Interface," line 2) to provide users with access to the many services on the Internet including a paid service by commercial organizations which charges customers for access to specific services (page 2, section entitled "Who will use these systems?" and page 5, lines 11-12). It would have been obvious to an artisan of ordinary skill to incorporate such means for accessing and software for interfacing with the Internet in a kiosk information system, as taught by the Shah article, within the kiosk information system of Exhibit E in order to provide users with access to the many services available on the Internet.

Regarding claim 7, Exhibit E provides for a touch screen interface and touch screen means for accepting input information (Exhibit E, second page, first column, first and second paragraphs; second page, second column, second paragraph).

Regarding claim 8, Exhibit E provides for printing a detailed receipt (Exhibit E, second page, first column, second paragraph) or any other document retrieved from a remote source (Exhibit E, second page, second column, second paragraph, lines 9-13).

Regarding claim 9, Exhibit E provides for a durable enclosure (Exhibit E, photo of housing on first page).

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***Response to Arguments***

8. Applicant's arguments filed April 17, 2000 have been fully considered but they are not persuasive.

Regarding the objection to Figure 2, applicant points to col. 1, lines 36-56 as providing support for the terminal housing incorporating a monitor, keyboard, and credit card reader. However, this passage refers to various capabilities in prior U.S. patents to other inventors; it does not describe applicant's own invention as including a housing incorporating the depicted elements. Nowhere in the original specification is there any description of a terminal housing incorporating all the elements of Figure 2. Applicant further points to specific passages in U.S. patents to other inventors. Applicant cannot rely on references to other U.S. patents to provide support for subject matter missing from applicant's own written description.

Regarding the rejections of claims 1-4, 6-9 under 35 USC 112, 1st paragraph, applicant again points to other U.S. patents cited in the section entitled "Description of Prior Art" as providing support for the subject matter newly added to the original specification. However, it is the applicant's own written description of his invention which should clearly and fully describe the invention contemplated by the applicant. Although applicant has removed references to the "printer paper discharge chute" and "access door," there remains the added material in col. 2, lines 3-7 and col. 2, line 53 - col. 3, line 3 which describes a housing including therein a monitor, credit card reader swipe device, a keyboard, a printer and touch screen. These elements being

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incorporated within a terminal housing or “durable enclosure” was not described in the original disclosure as a feature of applicant’s invention and, therefore, constitutes new matter.

In response to applicant's argument that there is no suggestion to combine the references (Exhibits E and F in the TouchNet protest), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Exhibit E describes a TouchFax terminal which clearly allows interaction with commercial on-line services (via touchscreen and computer modem; second page, second column, second paragraph) and with credit card centers (via credit card reader; second page, first column, second paragraph, lines 4-6). Exhibit E differs from claims 1-4 only in that it does not *explicitly* state the use of software installed into the CPU to carry out its disclosed communication operations. However, Exhibit F further describes a TouchFax terminal in which it is stated that software is installed into the CPU to carry out its communication functions (first page, second paragraph) such that it would have been obvious to an artisan of ordinary skill to incorporate the use of installed software, as taught by Exhibit F to be a well known means in a TouchFax terminal for carrying out the communication operations, within the TouchFax terminal described in Exhibit E in order to carry out the disclosed communication operations.

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Regarding applicant's argument that Exhibits E and F are not proper prior art, the examiner disagrees. Exhibit E is a magazine article entitled "TouchFax Provides the Ultimate in Place-Based Interactivity," *published* in October 1992 by Allen Weiner in the magazine Interactive World. A published article in a magazine directed to interactive technology is clearly accessible to the public and to persons concerned with the art. Furthermore, MPEP 2128.02 states that a journal article or other publication becomes available as prior art on date it is received by a member of the public and, thus, "a magazine or technical journal is effective as of its date of publication." Exhibit F is a brochure made available to the public in 1991, well before the filing date of applicant's invention, and describing a product available for public use and sale by TouchFax Information Systems, Inc. Applicant has not provided evidence that Exhibit F was not accessible to the public.

Applicant further argues that Exhibit E lacks a "means for accessing commercial on-line services." The examiner contends that Exhibit E provides for accessing and retrieving documents from remote service providers (second page, second column, second paragraph, lines 9-13) and paying for such services via credit card reader (second page, first column, second paragraph) such that the on-line service provided in Exhibit E can be considered "commercial."

Regarding claims 6-9, applicant argues that "Exhibit E never discusses the Internet." However, the examiner relied upon the article by Rawn Shah, *not* Exhibit E, to show the desirability of accessing and interacting with the Internet from a kiosk terminal.

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Applicant further argues that the Shah article is not proper prior art because “it is not indexed or catalogued in any library or other location accessible to the public.” However, an electronic publication need not be indexed or catalogued in a library to be considered as prior art. MPEP 2128 (section entitled “ELECTRONIC PUBLICATIONS AS PRIOR ART”) clearly states that “[a]n electronic publication, including an on-line database or Internet publication, is considered to be a ‘printed publication’ within the meaning of 35 USC 102(a) and (b) provided the publication was accessible to persons concerned with the art to which the document relates” and “[p]rior art disclosures on the Internet or on an on-line database are considered to be publicly available as of the date the item was publicly posted.” Therefore, the article by Shah describing suggestions for information kiosks and posted on the Internet can be considered as a “printed publication” within the meaning of 35 USC 102(a) and (b) and accessible to persons concerned with the kiosk art.

9. Applicant's arguments with respect to claims 6-9 (specifically, software for interfacing with credit card centers) have been considered but are moot in view of the new ground(s) of rejection.

10. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

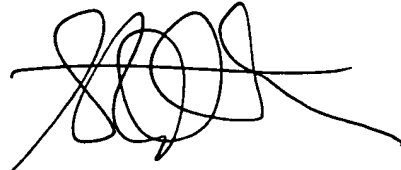
(703) 872-9314.

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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella Woo whose telephone number is (703) 305-4395 and can normally be reached from 6:00 a.m. until 2:30 p.m., Monday through Friday.

June 8, 2001



STELLA WOO  
PRIMARY EXAMINER





Atty. Dkt. No. 6388.005/EWG

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:  
RICHARD P. METTKE

Serial No.: 09/134,831

Filed: August 17, 1998

For: ON-LINE COMMUNICATION  
TERMINAL/APPARATUS

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Group Art Unit: 2743

Examiner: Stella Woo

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Technology Center 2600

**AMENDED<sup>1</sup> AMENDMENT AND RESPONSE TO  
OFFICE ACTION DATED JUNE 11, 2001**

Box FEE  
U.S. Patent and Trademark Office  
P.O. Box 2327  
Arlington, VA 22202

Dear Sir/Madam:

CERTIFICATE OF MAILING	
I hereby certify that this correspondence is being deposited on November 27, 2001, with the U. S. Postal Service, as Certified Mail, Return Receipt Requested, CM # Z 331 668 524 in an envelope addressed to: BOX FEE U.S. Patent and Trademark Office, P.O. Box 2327, Arlington, VA 22202.	
Date 12/05/01	Signature Cindy Bernhard

In response to the Office Action mailed on June 11, 2001, Applicant files the following Amendment and Response. Reconsideration of this application is respectfully requested.

Claim 1-4 and 6-9 are pending in the reissue application. Claims 1-4 and 6-9 have been rejected. In a previous Amendment, claims 1-4, and 6-9 were amended. By this Amendment, claims 1-4 have been cancelled and claim 7 and 9 have been amended again. However, in compliance with the rules of practice in connection with reissue applications, these amendments have been made with respect to the claims as they stood

<sup>1</sup> This Amended version of the Amendment and Response to Office Action previously filed in response to the June 11, 2001 Office Action is being submitted in response to the Notice of Non-Compliant Amendment mailed on October 18, 2001.

at the time of filing of this reissue application. In view of the following amendments and remarks, Applicant respectfully requests allowance of claims 6-9.

**IN THE CLAIMS**

Please cancel claims 1, 2, 3 and 4 without prejudice.

Please amend claim 7 as follows:

7. The terminal of claim 6, wherein the means for accessing includes a keyboard which communicates with and controls a microprocessor.

Please amend claim 9 as follows:

9. The terminal of claim 6, wherein the terminal comprises a CPU, monitor, credit card reader swipe device, internal modem and printer.

## REMARKS

### **I. Drawings**

The Examiner has again objected to the drawings on the alleged grounds that the original disclosure does not support the showing of the terminal housing as depicted in Figure 2, which was submitted as part of a substitute sheet of Figure 2 during the prosecution of the original patent. Applicant again respectfully disagrees with the Examiner's objection because the substitute drawing of Figure 2 does not constitute new matter.

Information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter. As stated previously, Figure 2 shows one embodiment of the Applicant's claimed invention, each aspect of which is clearly described in the originally filed specification. For clarity, references to the places where such disclosures are made will be to the column and line corresponding to U.S. Patent No. 5,602,905 as issued. Note that the support for Figure 2 is found outside of that part of the specification which the Examiner has designated as "new matter."

Figure 2 shows a monitor 11, which is disclosed in the '905 patent at col. 2, line 43. The credit card swipe reader 12 of Figure 2 is disclosed at col. 2, line 45. The keyboard 13 is disclosed at col. 2, line 43. The printer is disclosed at col. 2, lines 44-45. At col. 2, line 42, the specification clearly states that the "Terminal device...is comprised of" the several components just described. (Emphasis added.) Clearly, the text of the specification describes exactly what it depicted in Figure 2, namely a Terminal comprising a monitor, a credit card swipe reader, a keyboard, a printer and a CPU. figure

2 depicts one of many possible embodiments of the terminal disclosed in col. 2, lines 42-46. Applicant has previously amended the specification to remove the references to “printer paper discharge chute” and the “access door” and submitted a substitute drawing of Figure 2 removing these structures and their corresponding reference numerals.

For the above reasons alone, Applicant believes that the Examiner’s objections to Figure 2 should be withdrawn. However, Applicant maintains his position that the several U.S. Patents listed in the specification of the ‘905 patent also support the Terminal depicted in Figure 2.

Applicant respectfully submits that Figure 2 does not constitute new matter and respectfully requests that the objection to Figure 2 be withdrawn.

## **II. Claim Rejections – 35 U.S.C. § 112**

Claims 2, 4, 7, and 9 have been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. In light of the cancellation of claims 2 and 4, and the amendments to claims 7, and 9, Applicant respectfully requests that these rejections be withdrawn.

## **III. Claim Rejections – 35 U.S.C. § 103(a)**

### **A. Summary of the Examiner’s Rejections**

Claims 1-4 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the article entitled “TouchFax Provides the Ultimate in Place-Based Interactivity” (hereafter “Exhibit E” for consistency with the Office Action) in view of the TouchFax

brochure entitled "Vision, Power, Versatility" (hereinafter "Exhibit F" for consistency with the Office Action). Insofar as these claims have been cancelled without prejudice, this rejection is moot at this time and will not be addressed any further.

Claims 6-9 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Exhibit E in view of Exhibit F and further in view of an article by Rawn Shah entitled "Suggestions for Information Kiosk Systems using the World Wide Web" ("Shah Article").

#### **B. Response To Rejections**

Claims 1-4 and 6-9 are patentable over all of the references cited by the Examiner in the Office Action. None of the references cited by the Examiner discloses, teaches or suggests a pay-as-you-use computer terminal providing access to the Internet as claimed by Applicant. The Examiner has found it necessary to combine three different references to formulate this rejection but has entirely failed to identify any motivation to combine the combination of Exhibits E and F with the Shah Article. For that reason alone, the Examiner has failed to establish a *prima facie* case of obviousness of claims 6-9. Moreover, Applicant still maintains his argument that none of Exhibits E, F or the Shah Article are proper prior art. However, these arguments will not be repeated a second time.

Assuming for the sake of argument that the combination of Exhibits E and F is appropriate, and that this combination differs from claim 6 only insofar as the combination does not specify accessing and interfacing with the Internet, Applicant nevertheless traverses the Examiner's rejection of claim 6.

The Shah Article does not disclose or suggest that a credit card swipe device should be employed to charge a user for use of the terminal. The Shah Article does not even discuss the use of a credit card swipe device. It merely suggests that registration system should be used so that commercial organizations, as opposed to the terminal owner, can bill the user for the services provided. This is entirely different from charging for use of the terminal itself. Further, as the Examiner admits, Exhibits E and F together do not specify accessing and interfacing with the Internet. Therefore, even the combination of the three references together do not disclose or suggest the use of a credit card swipe device to charge for the use of a terminal which provides access to the internet.

Nor is there any suggestion to combine Exhibits E and F with the Shah Article to produce the claimed terminal. Exhibits E and F were directed to accessing certain stand-alone databases, not the Internet. In fact, Exhibits E and F were specifically directed to charging the user for use of the *service*, not for use of the *terminal*. Neither of these references contemplated the broader and more ingenious idea of allowing access to the Internet, and then charging the user for access to the *terminal*.

None of the references discloses or suggests charging users for terminal access. None of the references discloses or suggests the use of a credit card swipe device to access the Internet. There is no suggestion to combine Exhibits E and F with the Shah Article.

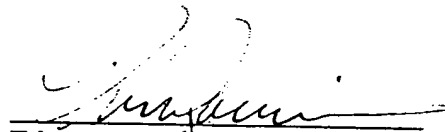
Accordingly, in view of the above remarks and amendments, Applicant respectfully submits that claim 6 is allowable. Because every element in independent claim 6 is not disclosed, taught or suggested in the references cited by the Examiner,

rejection under 35 U.S.C. §103(a) is improper. Therefore, Applicants respectfully request that the rejection of claims 6-9 under 35 U.S.C. § 103(a) be withdrawn.

### CONCLUSION

In view of the above amendments and remarks, Applicant respectfully requests withdrawal of the rejections and allowance of claims 6-9.

Respectfully submitted,



Edward W. Goldstein

Reg. No. 22,945

**Goldstein & Polasek, L.L.P.**

1177 West Loop South, Suite 400

Houston, TX 77027

F:\CLIENT\6\6388\005\PTO\ROA 61101.doc

**VERSION OF CLAIMS WITH MARKINGS TO SHOW CHANGES MADE**

7. The terminal of claim 6, wherein the means for accessing includes a keyboard [touch screen interface attached to the monitor and further includes a touch screen means for accepting input information from the touch screen interface and modifying program execution accordingly] which communicates with and controls a microprocessor.

9. The terminal of claim 6, wherein the [housing includes] terminal comprises a [durable enclosure for the] CPU, monitor, credit card reader swipe device, internal modem and printer[, and a secured access door for service and repair].



11 MAR 02



**Action Summary**

Application No. 09/134,831	Applicant(s) Mettke
Examiner Stella Woo	Art Unit 2643

MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Reply**

EXTENDED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM MAILING DATE OF THIS COMMUNICATION.

Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

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DEC 06 2002

Technology Center 2600

**Status**

- 1) ☒ Responsive to communication(s) filed on Dec 11, 2001
- 2a) ☒ This action is FINAL.
- 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-9 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - a) ☐ All b) ☐ Some\* c) ☐ None of:
    - 1. ☐ Certified copies of the priority documents have been received.
    - 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

ENC 12

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## DETAILED ACTION

### *Drawings*

1. The drawings are objected to because the original disclosure does not support the showing of the terminal housing as depicted in Figure 2, which was submitted as part of a substitute sheet of drawing during the prosecution of the original patent for the same reasons given in the last Office action. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. Figure 2, as originally filed, showed a cubicle with a work area/desk top, privacy wall, chair/stool and a terminal device generally labeled as numeral 2. There is no support in the original disclosure for the terminal housing as incorporating the monitor, keyboard, and credit card reader in the manner depicted in the current Figure 2. Correction is required.

2. The proposed substitute sheet of drawings (substitute Figure 2), filed on April 17, 2000 has been disapproved because it introduces new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of a housing incorporating a monitor, keyboard, and credit card swipe device in the manner depicted such that the substitute Figure 2 does not remedy the objection to the drawings given in the last Office action and repeated above.

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***Specification***

3. As previously addressed in the last Office action (paragraph 4), new matter was added as an amendment to the specification during the prosecution of the original patent. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: col. 2, lines 3-7; col. 2, line 53 - col. 3, line 3.

Applicant is required to cancel the new matter in the reply to this Office action.

***Claim Objections***

4. Claim 9, as amended in the paper filed December 11, 2001, is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claims 9 recites a "CPU, monitor, credit card reader swipe device, internal modem and printer." These limitations are already recited in claim 6, from which claim 9 depends.

Applicant is required to cancel the claim or amend the claim to place the claim in proper dependent form.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any

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person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Claim 7, as amended in the paper filed December 11, 2001, recites "a keyboard which communicates with and controls a microprocessor" which is not supported by the original disclosure as filed on January 23, 1995. The original disclosure makes no mention of the keyboard controlling a microprocessor. Furthermore, there is no provision in the original disclosure for "a microprocessor" in addition to the "CPU" already recited in claim 6, upon which claim 7 depends.

Applicant is required to cancel the new matter in the reply to this Office action.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the article entitled "TouchFax Provides the Ultimate in Place-Based Interactivity" (submitted as Exhibit E in the TouchNet Protest on November 4, 1998, hereinafter "Exhibit E") in view of the TouchFax brochure entitled "Vision, Power, Versatility" (submitted as Exhibit F in the TouchNet Protest on November 4, 1998, hereinafter "Exhibit F"), and further in view of an article by Rawn Shah entitled "Suggestions for Information Kiosk Systems using the World Wide Web", submitted with the Protest by North Communications, Inc. as Exhibit I (hereinafter "the Shah article") for the same reasons given in the last Office action and repeated below.

Exhibit E discloses a public on-line, pay-as-you-use communications terminal (TouchFax public terminal; Exhibit E, first page, fifth paragraph) comprising:

a central processing unit (386 microprocessor; Exhibit E, second page, first column, third paragraph, line 3);

a telephone access node (data port; Exhibit E, second page, first column, third paragraph, line 3);

an internal modem (modem; Exhibit E, second page, first column, third paragraph, line 5 and second column, second paragraph, line 11);

a video display monitor (touch-sensitive color video monitor; Exhibit E, second page, first column, first paragraph and lines 2-3 of the third paragraph);

a keyboard (full-size keyboard; Exhibit E, second page, first column, third paragraph, lines 4-5);

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a credit card reader (Exhibit E, second page, first column, second paragraph, lines 4-6);  
means for accessing and allow for user interaction (via touchscreen and computer modem;  
Exhibit E, second page, second column, second paragraph);  
a printer (high-volume laser printer; Exhibit E, second page, first column, third paragraph,  
line 4).

Exhibit E differs from claim 6 in that it does not *explicitly* recite software installed into the CPU to allow interaction with credit card centers. However, Exhibit F teaches the use of such software installed into the CPU of a TouchFax terminal to carry out its communications functions (Exhibit F, first page, second paragraph) such that it would have been obvious to an artisan of ordinary skill to use such installed software, as described in Exhibit F within the TouchFax terminal of Exhibit E to carry out its communications functions with the credit card centers in order to authorize payments made via the credit card reader.

The combination of Exhibits E and F differs from claim 6 in that it does not specify accessing and interfacing with the Internet. However, the combination does allow for accessing and interfacing with a remote service provider via a modem and the Shah article teaches the desirability of providing access to and interaction with the Internet in a kiosk-based information system (pages 1-2, section entitled "The Effectiveness of the World Wide Web as Kiosk-based Information System") via the use of appropriate software (Web browser; page 2, section entitled "The Access Interface," line 2) to provide users with access to the many services on the Internet including a paid service by commercial organizations which charges customers for access to

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specific services (page 2, section entitled “Who will use these systems?” and page 5, lines 11-12). It would have been obvious to an artisan of ordinary skill to incorporate such means for accessing and software for interfacing with the Internet in a kiosk information system, as taught by the Shah article, within the combination of Exhibits E and F in order to provide users with access to the many services available on the Internet.

Regarding claim 7, Exhibit E provides for a keyboard (full-size keyboard; Exhibit E, second page, first column, third paragraph, lines 4-5).

Regarding claim 8, Exhibit E provides for printing a detailed receipt (Exhibit E, second page, first column, second paragraph) or any other document retrieved from a remote source (Exhibit E, second page, second column, second paragraph, lines 9-13).

Regarding claim 9, as described above with regard to claim 6, Exhibit E provides for a central processing unit (386 microprocessor; Exhibit E, second page, first column, third paragraph, line 3), a monitor (touch-sensitive color video monitor; Exhibit E, second page, first column, first paragraph and lines 2-3 of the third paragraph), a credit card reader swipe device (Exhibit E, second page, first column, second paragraph, lines 4-6), an internal modem (modem; Exhibit E, second page, first column, third paragraph, line 5 and second column, second paragraph, line 11), and a printer (high-volume laser printer; Exhibit E, second page, first column, third paragraph, line 4).

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*Response to Arguments*

9. Applicant's arguments filed December 11, 2001 have been fully considered but they are not persuasive.

Regarding the objection to Figure 2, applicant argues that the components depicted in Figure 2 are disclosed in the original specification. The examiner contends that the disclosure fails to provide for the terminal as comprising the various components in the manner depicted in Figure 2, that is, within a single housing. Rather, Figure 2, as *originally* filed, showed a cubicle with a work area/desk top, privacy wall, chair/stool and a terminal device generally labeled as numeral 2.

Again, applicant points to other U.S. Patents listed in the specification as providing support for the terminal housing incorporating a monitor, keyboard, and credit card reader. However, this passage refers to various capabilities in prior U.S. patents to other inventors; it does not describe applicant's own invention as including a housing incorporating the depicted elements. Nowhere in the original specification is there any description of a terminal housing incorporating all the elements of Figure 2. Applicant cannot rely on references to other U.S. patents to provide support for subject matter missing from applicant's own written description.

In response to applicant's argument that there is no suggestion to combine the references (Exhibits E and F with the Shah article), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the



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references themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958

F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the combination of Exhibits E and F

differs from claim 6 in that it does not specify accessing and interfacing with the Internet.

However, the combination does allow for accessing and interfacing with a remote service provider

via a modem and the Shah article teaches the desirability of providing access to and interaction

with the Internet in a kiosk-based information system (pages 1-2, section entitled "The

Effectiveness of the World Wide Web as Kiosk-based Information System") via the use of

appropriate software (Web browser; page 2, section entitled "The Access Interface," line 2) to

provide users with access to the many services on the Internet including a paid service by

commercial organizations which charges customers for access to specific services (page 2, section

entitled "Who will use these systems?" and page 5, lines 11-12). The examiner maintains that it

would have been obvious to an artisan of ordinary skill to incorporate such means for accessing

and software for interfacing with the Internet in a kiosk information system, as taught by the Shah

article, within the combination of Exhibits E and F in order to provide users with access to the

many services available on the Internet. In this way, the user is not limited to retrieving

information from only one remote service provider.

Applicant further argues that "[n]one of the references discloses or suggests the use of a

credit card swipe device to access the Internet." The examiner contends that the combination

clearly provides for a credit card swipe device (Exhibit E shows a credit card reading device for

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accepting payment to retrieve information from a remote service provider; second page, first column, second paragraph, lines 4-6) such that the combination of Exhibits E, F and Shah would result in the use of the credit card reader swipe device to pay for the ability to retrieve information from the Internet.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

11. **Any response to this final action should be mailed to:**

**Box AF**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

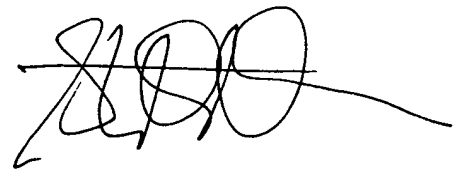
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**or faxed to:**

(703) 872-9314; (for formal communications, please mark "EXPEDITED  
PROCEDURE"; and for informal or draft communications, please label  
"PROPOSED" or "DRAFT").

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella Woo whose telephone number is (703) 305-4395. Any general inquiries should be directed to the Customer Service Office at (703) 306-0377.

March 11, 2002

A handwritten signature in black ink, appearing to read 'Stella Woo', with a long horizontal line extending to the right.

**STELLA WOO  
PRIMARY EXAMINER**



**EXPEDITED PROCEDURE**

*PTO Rec'd  
25 APR 02*

**APPN:** 09/134,831

**Filed:** August 17, 1998

**Applicant:** Richard P. Mettke

**Title:** On-line Communications Terminal/Apparatus

**Group Art Unit:** 2743

**Examiner:** Stella Woo

**AMMENDMENT AND RESPONSE TO  
OFFICE ACTION DATED 12 MARCH 2002**

**RECEIVED**

**DEC 06 2002**

**Technology Center 2600**

<p align="center"><b>CERTIFICATE OF MAILING</b></p> <p>I hereby certify that this correspondence is being deposited on _____, with the US Postal Service with return receipt requested. The envelope was addressed to Box AF, Commissioner of Patents and Trademark, Washington DC, 220231</p>
------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------

**Box AF,  
Commissioner of Patents and Trademarks,  
Washington D.C. 20231**

*25 APR 02*

**Dear Sir/Madam:**

In response to the Office Action mailed on March 12, 2002, Applicant files the following amendment and response. This response is being filed prior to June 12, 2002 and as such no fees are due. Claims 1-4 and 6-9 are pending in the reissue application. Claims 1-4 and 6-9 have been rejected. Claims 1-4 and 6-9 have been amended and examiner objections to the specification have been corrected. In view of the following amendment and remarks, applicant respectfully request allowance of claims 1-4 and 6 & 8.

*13 APR 02  
ENCL 13*

**In The Specification:**

Delete column 2, line 3-7, column 2, line 53; and column 3, line 3

**In the Claims:**

Cancel Claim 7

Cancel Claim 9

**REMARKS**

**I. DRAWINGS.**

The examiner objected to the submitted corrected drawing because the original disclosure does not support showing the terminal housing as depicted in figure 2 and introduces “new matter” not disclosed in the original disclosure. The Applicant strongly disagrees that the original disclosure does not support a terminal or “housing”. The original specification states “...terminal to include.....” numerous times in the original disclosure. **It would be obvious to some one skilled in the art that the words and meanings of “terminal” and “housing” are synonymous as portrayed in the original disclosure.** In, addition the prior art provided, demonstrates this contention. Where else would the components listed in the specification be housed? The Applicant would like to point out to the examiner that in accordance with MPEP guidelines that if an applicant amends or attempts to amend the abstract, specification or drawings of an application, an issue of new matter will arise if the content of the amendment is not described in the application as filed. Stated another way, information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter.” The words “**terminal to**

**include.....**” are well documented in the original specification. The substituted drawing (Attachment 1) is resubmitted for the examiners reconsideration. Respectfully request allowance.

## **II. The objection to the claims rejection under 35 USC 103.**

The claims 1-4 and 6-9 were rejected under 35 USC 103 (a) objected to as being unpatentable over the article entitled “TouchFax provides the Ultimate in Place-based Interactivity” (submitted as Exhibit E in the Touchnet Protest on November 4,1998” in view of the Toch Fax brochure entitled “Vision, Power, Versatility” (submitted as Exhibit F in the TouchNet Protest on November 4, 1998). The applicant respectfully requests that the rejection be withdrawn and an allowance be granted. The applicant provides the following facts to support this request.

### **“TouchFax provides the Ultimate in Place-based Interactivity” (Exhibit E) Analysis-**

The examiner points out that Exhibit E discloses a public on-line, pay-as-you-use communications terminal (first page, fifth paragraph) comprising:

- a central processing unit (386 processor, Exhibit E, second page, first column, third paragraph, line 3)

- a telephone access node ( data port, Exhibit E, second page, first column, third paragraph, line 3)

- an internal modem (modem, Exhibit E, second page, first column, third paragraph, line 11)

- a video display monitor (touch sensitive monitor; Exhibit E, second page, first column, first paragraph, lines 2-3 of the third paragraph)

a keyboard (full sized keyboard; Exhibit E, second page, first column,  
third paragraph, line 4-5)

a credit card reader (Exhibit E, second page, first column,  
Second paragraph, line 3); means for accessing commercial on-line services and  
allow for user interaction (via touchscreen and computer modem; Exhibit E,  
second page, second column, second paragraph).

A printer (high volume laser printer; Exhibit E, second page, first column,  
Third paragraph, line 4)

Specifically; the article does not mention anywhere in the brochure that it is a  
public on-line communications terminal capable of accessing the Internet as the  
examiner contends. That is strictly a strained interpretation by the examiner. The  
following is the paragraph quote verbatim from the TouchFax Brochure:

**“TouchFax hardware products include three models of public terminals used  
initially as pay-per-use fax machines. They can provide other service such as  
word processing and high quality copies in addition to its primary capability  
of phone, fax and computer. Service products include personal fax boxes and  
information services which may be accessed by TouchFax public terminals  
and any private fax machines”**

The paragraph cited above does not mention connectivity to the Internet nor  
anything about being an on-line communications terminal. The article goes on to  
state the capabilities of each of the three terminals (page two, column one,  
paragraph 3). The following is the paragraph cited by the examiner for most of the  
rejections (verbatim).

**“The TF750 is a free-standing kiosk with high resolution, 14 inch screen, touch screen monitor, 386 processor, high volume laser printer and data port. The TF 450 is a built in, wall-mounted unit that has an optional floor mount and offers data ports for modem and laptop connections on an optional basis. The TF 200 is a built-in , wall mounted unit that offers laser printer as an upgraded feature.**

A simple analysis of the paragraph and it should be self-evident that these terminals do not access the Internet on a pay-as –you –use basis. Furthermore, the only information services that the terminals offer is a database to OAG with a response delivered by FAX (Page two, column 2, paragraph 2, lines 4-10). The other services (special newsletter and information) listed in the article are only obtainable from a touch tone phone and from a home or office (Page two, column 2, paragraph 3 and 4).

The examiner cites the following in the office action as part of the rejection  
“a credit card reader (Exhibit E, second page, first column, second paragraph, line 3); means for accessing commercial on-line services and allow for user interaction (via touchscreen and computer modem; Exhibit E, second page, second column, second paragraph).”

The words “means for accessing commercial on-line services” has apparently been inserted by the examiner. The Applicant protests the insertion, which modifies the capabilities of the terminals in the article.



### **“Vision, Power, Versatility Analysis-**

The applicant would again, Like to point out to the examiner that the brochure does not pass the prior art test. There is no date of publication, nor is there a date when it was put in to circulation. Two critical tests for prior art. Nonetheless, the applicant will address the issues of the TF700 terminal that were not addressed above.

The additional items that the applicant would like to point out on this terminal, is that the capabilities listed are (verbatim): **telephone, send or receive Fax, photocopying, word processing, and access to a growing network of information data bases from the wall street news to international sports scores”.**

The applicant’s previous comments and Exhibit E explicitly states how the databases are accessed, via a touch-tone phone and “faxed “to the user. **Nothing about accessing the Internet.**

Request that the examiner, in light of the above arguments withdraw the objection. Furthermore, the applicant would like to point out to the examiner that mere fact that the prior art may be modified in the manner suggested by the examiner that it does not make the modification obvious unless the prior art suggested the desirability of the modification. The prior art fails to show the desirability of the examiners proposed modification. The applicant would also like to point out that obviousness may not be established using hindsight. It

appears to be the case as demonstrated in the examiners interpretations of the articles (exhibits E and F).

An analysis of the exhibits the that examiners provided as a basis for the rejection would show that none of the cited art provide all of the elements of the applicants claims **(specifically, a pay-as-you-use terminal to access the Internet).**

Substantially modifying the references is not suggested by the references themselves, nor has the examiner presented a prima facie case to explain why someone skilled in the art would have made such changes to the prior devices referenced.

The applicant feels that the arguments provided above adequately address the rejections as they relate to exhibits E and F and should require reconsideration by the examiner.

**The following argument address “the shah” article and the examiners “combining of prior art references”.**

Again, the applicant would like to point out that the article **does not pass the prior art test**. The article is dated 30 April 1994, but there is no mention of **when it was posted on the WWW or the distribution of the article**. Two critical factors in determining prior art applicability that the Applicant requests that the examiner should reconsider.

Nevertheless, the applicant feels that the examiner has a strained interpretation of the paper. The following specifics are provided for the examiners consideration:

- The examiner cites “.....the shah article teaches the desirability of access to and interaction with the Internet in a kiosk-based information system (pages 1-2, section entitled ‘The Effectiveness of the World Wide Web as a Kiosk based Information System’) via the use of appropriate software (Web browser; page 2, section entitled “The Access Interface, Line 2) to provide users access to many services on the Internet including a paid service by commercial organizations which charges customers for access to the specific services (page 2 section entitled “ Who will use these systems?” and page5 lines 11-12).
- The examiner clearly has a strained interpretation of “the Shah” article. The applicant protests the examiner addition of materiel and modification of the material that is not explicitly stated in the article.
- Specifically, an analysis of the paragraph that the examiner references above (The Effectiveness of the World Wide Web as a Kiosk based Information system, page 1-2). The reference simply describes the World Wide Web and its capabilities. The examiner references “to provide users access to many services on the Internet including a paid service by commercial organizations which charges customers for access to the specific services (page 2 section entitled “ Who will use these systems?” and page5 lines 11-12).” But the words the examiner uses are not verbatim from the article and have been modified to relay the examiner wishes. This is inappropriate. It is not with an examiners purview to “add words” and modify the intent of prior art. Prior art

should stand on its own. Specifically, no where in the article does it state to “which charges customers for access to the specific services.”

- The examiner misinterpreted “Commercial Information referral organizations who wish to provide a paid service through such kiosks (“Who will use these systems?” , page5 lines 11-12). It is clear that the intent of this service is for an advertiser or an organization that wishes to list something for sale on the kiosk (i.e. Realtor, retailer )
- No where in the article does it mention that it is a point-of-sale, pay-as-you-use terminal to access the Internet. Furthermore, in the paragraph, “The Access Interface” pages 2-3 it does not specifically address a credit card swipe nor a telephone access node that is in the applicants claims (nor anywhere in the article). It does mention **network connection**. But, does not talk about connection to the **Internet**, only “a network”.

A thorough analysis of the “shah article” that <sup>the</sup>examiners provided, as a basis for the rejection would show it does not provide all of the elements of the applicants claims (specifically, a pay-as-you-use terminal to access the Internet and a telephone node). Substantially modifying the references is not suggested by the references themselves, nor has the examiner presented a prima facie case to explain why someone skilled in the art would have made such changes to the prior devices referenced.

The applicant respectfully submits that the Examiner improperly combined the references. In previous rulings it is stated that, “Obviousness can only be established by combining or modifying the teachings of the prior art to produce

the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The level of skill in the art cannot be relied upon to provide the suggestion to combine references.”

**Further rulings state:**

“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”

“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.”

The applicant has provided at attachment 2, a statement from the acting Director of Information Management, Fort Leonard Wood, Missouri, Mr. Greg Adank. In this statement, Mr. Adank has provided an independent analysis of the three items of prior art as they relate to the Applicants specification and his conclusions. Mr. Adank has also provided a straight forward matrix in his analysis that crosswalks the elements of the Applicants claims and the prior art cited by the examiner. His conclusions should assist the examiner in a decision to allow the reissue application.

Based on the above response and corrections made to the claims and drawing, Applicant respectfully requests that the rejection be withdrawn and allowance be provided.

The applicant has made a diligent effort to amend the claims of the application so that it is at an allowable state that defines a novel structure, unobvious because it produces new and unexpected results at the time of the application. If for any reason the claims of this amendment and response are not believed to be in condition for allowance, the applicant respectfully requests that constructive assistance and suggestions of the examiner pursuant to MPEP 707 07 (j).

Sincerely,

Richard P. Mettke  
Ex parte,

505 Stone Ridge Drive,  
Waynesville, MO 65583

Voice: 573-336-5726  
FAX: 573-336-7093

Email: rmettke@aol.com

# FIGURES

Figure 1-

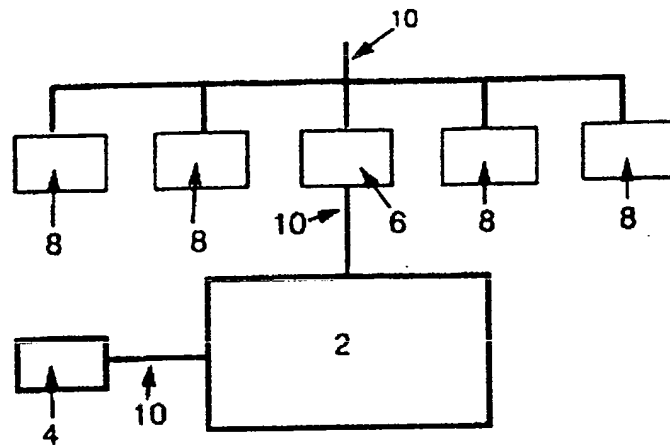
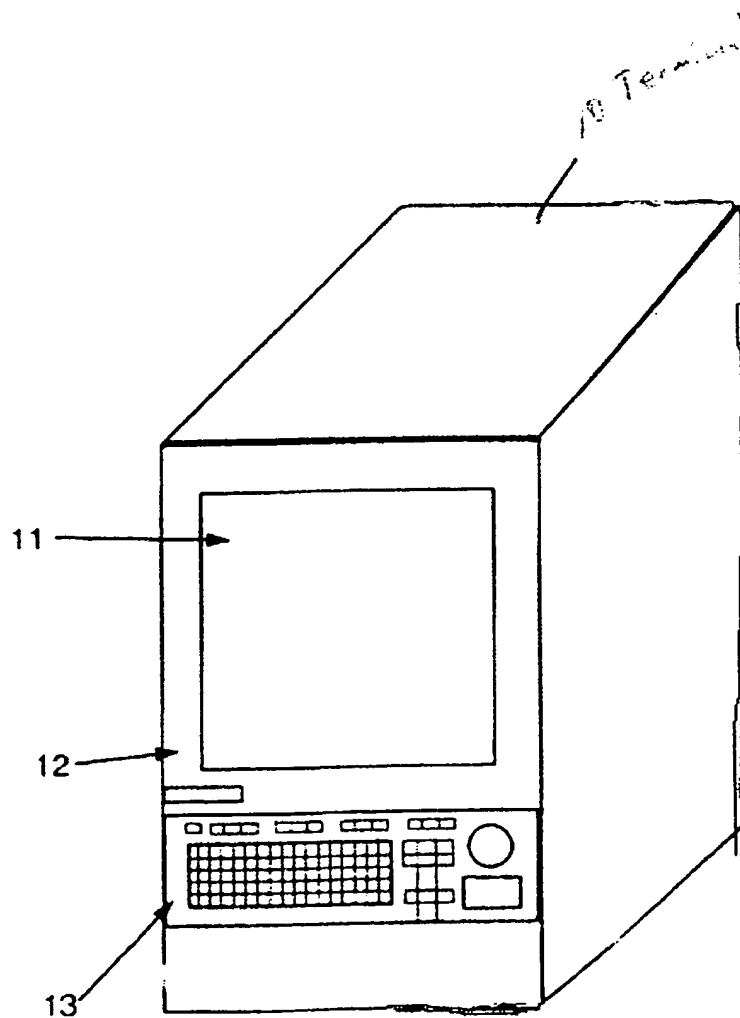


Figure 2-



Attachment 1

Mr. Richard P. Mettke

April 6, 2002

Reference: Patent Number: 5,602,905

Dear Mr. Mettke,

Upon complete review of your original patent application (8/376247) and patent number 5,602,905, reissue amendment filed on DEC 11, 2001, and USPTO Office Action dated MAR 12, 2002 (Examiner Woo), I would submit to you the following observations as someone skilled in the art.

**General Observations:** The patent application articulates well a multitude of automation capabilities that one should considered "commonplace" in 1994. Typical home and business computers (Intel based 286/386 and other compatible class processors) were capable of performing all tasks and features described in your background description of prior art. Specifically, those systems were capable of sending and receiving faxes via internal or external modem, generating electronic documents and printing or faxing them to a remote terminal, communicate with on-line service providers (Prodigy, Compuserve, AOL), as well as be used to communicate on the Internet via Internet service provider (ISP). The ability to couple a credit card reading device to a computer terminal was also common place during this time as many point-of-sale devices (i.e. cash registers) were in fact systems built from the core components found inside a computer terminal.

**Understanding and Interpretation:** The most straightforward approach to building the terminal device described in your patent is to use and adapt operating systems, hardware, and software that was readily available. With commercial off the shelf (COTS) hardware and software available in 1994 and the details given in the referenced patent I submit the following comments with regard to the feasibility of building such a terminal device.

Attachment 2



1. The Microsoft Windows 3.1 operating system was released April, 1992 and was the most popular computer operating system on the market in 1994. Windows NT 3.1 was released August 1993. Either operating system could fully support the functionality needed to enable a computer terminal as described in your patent.
2. The ability to print information generated by or downloaded to the computer terminal is a common capability for such a device described in the patent. Operating systems identified in #1 above support a wide variety of laser quality printers, there is no particular challenge to make this feature work.
3. Given that the terminal device must communicate with on-line service providers, Internet service providers, and have the ability to send/receive faxes, it would be highly desirable to have a high-speed internal modem in the terminal. Such devices were readily available and could perform all communications tasks as defined in the patent.
4. Assuming that a Fax/Modem device is installed in the terminal I would point out that the software, which typically accompanies such devices, would fully enable the terminal to perform dial-up connections to on-line services, Internet services, and send/receive electronic faxes.
5. Microsoft Office was released in January 1990 and would provide an array of office automation capabilities on the terminal. Since your patent only identifies word processing I would select the Microsoft Word application, which was available as a separate software package, to provide word processing capabilities at the terminal device.
6. In order for the computer terminal to access on-line service providers (Prodigy, CompuServe, AOL) specialized software would be needed. It was, and still is, commonplace for such service providers to distribute dial-up software free of charge to customers that subscribe to their service. The computer terminal would need one copy of each on-line provider's access software package to properly communicate with their host network. In my experience it was commonplace for multiple on-line provider software packages to reside on a single computer terminal and would not present itself as a technical challenge to configure.

7. The computer terminal would also require specialized software to dial-up and obtain network connectivity from an ISP. As described in your patent this capability would enable the terminal user to send and receive email and locate information available on the Internet. Windows 3.1 and NT 3.1, along with the Internet Explorer web browser (which is part of the operating system) has sufficient dial on demand capabilities to support the task of providing ISP based services.

**Review of Figures:** The functional operation of this proposed terminal device is clearly illustrated in figure 1. It illustrates relationships between the general telephone switching network, on-line service providers, Internet service provider, and the computer terminal device. It further illustrates the functional relationship between the terminal device and a credit card service provider. As figure 1 illustrates, the computer terminal device may require a single plain old telephone system (POTS) circuit to perform credit card validation, dial-up access to on-line and Internet services, and send/receive faxes.

Figure 2 illustrates a physical layout of the computer terminal and cubical or privacy booth that would contain the device(s) identified in figure 1. What is not apparent in either figure, but what I perceive is implied in the patent, is that a housing would be used to store the computer terminal, input/output apparatus, and credit card swiping device. It would be highly desirable to centralize such components in a single enclosure and limit access to the devices through a customer service opening in the front, and a lockable access panel to protect and secure components from tampering and/or theft. Such enclosures were readily available on the market and are frequently used in manufacturing plants, assembly line operations, and in other environments where delicate devices must be protect from damage due to impact, natural elements, and/or vandalism. The computer terminal as described in the patent would easily fit within a single housing and does not present itself as a technical challenge.

**Evaluations of Exhibits:** The following table identifies the features and capabilities listed in or implied within each of the exhibits and the Mettke patent. Upon close

evaluation it is my opinion that none of the three exhibits provide at least the same services as described in the patent or reissue application. The TouchFax exhibits clearly provide a customer with advanced fax, copier, word processing, and proprietary database access to selected information. However, that system does not provide access to existing on-line service providers (i.e. Prodigy, CompuServe, AOL), nor does it suggest that the TouchFax devices have the capacity to offer direct Internet access through an ISP.

The Shah article provides a framework for building information kiosk system using the World Wide Web as it's primary communication and information infrastructure. While it lists and recommends much of the same equipment identified in the patent it clearly does not mention nor imply that such kiosk devices should offer customers access to existing on-line service providers, or the Internet on a point-of-sale basis, or provide pay-per-use send/receive fax service. The Shah article makes no mention of a credit card swipe reader. The following matrix identifies the similarities and differences in capabilities as stated and implied within each exhibit, the patent, and reissue patent.

<b>Feature</b>	<b>Exhibit E TouchFax</b>	<b>Exhibit F TouchFax</b>	<b>Exhibit I "Shaw" Article</b>	<b>Mettke Patent</b>	<b>Mettke Reissue Patent</b>
Access to Internet services			x	x	x
Access to on-line Services				x	
Advertisements and promotions	x	x	x		
Credit Card Reader	x	x		x	x
Data Ports	x	x			
Electronic Library	x	x			
Fax Mail Box Service	x				
Flat Bed Scanner Device	x	x			
High Quality Copier	x	x			
Keyboard	x	x	x	x	x
Laser Printer		x	x	x	x
Light-pen, stylus, keypad			x		
Multi-language support			x		
Network Connection Hardware			x		
Pay-per-use	x	(implied)	x	x	x
Phone	x	x			
Printed Receipt	x			x	x
Remote System Management		x	x		
Send/Receive Fax Services	x	x		x	x
Sound system			x		
Touch Fax Information Service	x	x			
Touch Net		x			
Touch Screen Monitor	x	x	x	x	x
Web Browser			x	(implied)	(implied)
Word Processing	x	x		x	x
See Footnotes:	1,2	3	4	5	

1. Makes vague reference to providing "...related services that relate to the type of people that frequent a particular type of location"

2. Electronic library produces "fax" output only, and on topics made available via proprietary databases (i.e. OAG Flight Fax for flight information)

3. On the bottom of page two, right hand corner, a vague comment is made to the product providing access to "...a universe of information available from On-line computer and fax information services." The nature of this advertisement implies that the on-line services provided are those available through a proprietary library service that the fax device will interact with and produce output from.

4. Makes no mention of kiosks that can access existing on-line service providers or their information (i.e. Prodigy, CompuServe, AOL) or the Internet

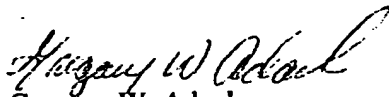
5. On-line services are defined in the patent as commercial services such as Prodigy, CompuServe and AOL.

**Conclusion:** Having reviewing the referenced patent and three exhibits I have formed the following professional opinions:

1. Having read and understood information provided in patent 5,602,905 and the reissue amendment it is my firm belief that the pay-per-use fax service, ability to access on-line service providers, and ability to access information on the Internet via ISP is feasible and defined sufficiently enough as to allow someone skilled in the art to build and deploy such a device.
2. Exhibits E and F clearly communicate that their primary capabilities are to provide word processing, copier, and fax services to the patron. These devices have the ability to interact with and retrieve information from a proprietary database, but only to the extent that the service provider has anticipated the needs of their customers and pre-loaded the information as to make it available. These devices clearly lack the ability to communicate or interact with data stores generally found on the Internet through an ISP. Neither do TouchFax devices allow access to existing on-line services, such as Prodigy, Compuserve and AOL or the Internet.
3. The Shah article provides a framework for building information kiosk system using the World Wide Web as it's primary communication and information infrastructure, however it does not state nor imply such devices should offer access to existing on-line service providers, the Internet, or a send/receive fax service on a point-of-sale basis.

**Personal Background and Credentials:** I currently work for the United States Government in the capacity of Acting Director, Information Management, at Fort Leonard Wood, Missouri 65473. Specific duties and technical skills include Network/System administrator of a 5000 node Campus Area Network composed of Windows and Unix based servers and desktop computers. Programmer, develops software applications using multiple high-level interpreted and compiled languages.

Adjunct Faculty member of Columbia College, Fort Leonard Wood Extended Studies Division, teaching numerous programming, software engineering, networking and data communications courses in the Computer Information Systems and Math department. Owner, VagaTech networking and Internet solution provider business operating in Waynesville, Missouri 65583. Education: Masters degree in Information Resource Management from Webster University, St. Louis Missouri, and an undergraduate degree in Computer Information Systems from Columbia College, Columbia Missouri. Contact Information: I can be reached via email: [greg@vagatech.com](mailto:greg@vagatech.com), phone: (573) 774-2544, or U.S. mail: 22740 Rose Meadow Lane, Waynesville, MO 65583

  
Gregory W. Adank

5-15-02

# **Advisory Action**

Application No.  
09/134,831

Applicant(s)  
Mettke

Examiner  
Stella Woo

Art Unit  
2643



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Apr 24, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

## **THE PERIOD FOR REPLY [check only a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: The proposed amdt. incorrectly states that claims 1-4, 6 and 8 are pending. Claim 1-4 were canceled in the amdt. filed 12-11-2001. Furthermore, the subject matter not supported by the original disclosure is col. 2, lines 3-7 and col. 2, line 53 through col. 3, line 3. This has not been deleted by the proposed amdt.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: the claims remain obvious in view of the prior art for the same reasons given in the final Office action.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_
- Claim(s) objected to: \_\_\_\_\_
- Claim(s) rejected: 6-9
- Claim(s) withdrawn from consideration: \_\_\_\_\_
8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

STELLA WOO  
PRIMARY EXAMINER  
ART UNIT 2643

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/134,831	08/17/1998	RICHARD P. METTKE	6388.005	8517

7590

05/15/2002

Richard Mettke  
505 Stone Ridge Drive  
Waynesville, MO 65583

EXAMINER

WOO, STELLA L

ART UNIT

PAPER NUMBER

2643

DATE MAILED: 05/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.





## EXPEDITED PROCEDURE

APPN: 09/134,831

Filed: August 17, 1998

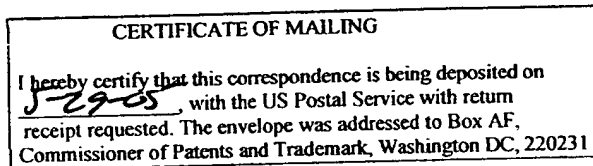
Applicant: Richard P. Mettke

Title: On-line Communications Terminal/Apparatus

Group Art Unit: 2743

Examiner: Stella Woo

### CORRECTED AMMENDMENT AND RESPONSE TO ADVISORY ACTION, DATED MAY 15, 2002



Box AF,  
Commissioner of Patents and Trademarks,  
Washington D.C. 20231

Dear Sir/Madam:

In response to the Advisory Action mailed on May 15, 2002, Applicant files the following corrected amendment and response. This response is being filed prior to August 15, 2002 and as such no fees are due. Claims 6 & 8 are pending in the reissue application. Claims 6-9 have been rejected. Claims 6 & 8 have been amended and examiner objections to the specification have been corrected (original Amendment). In view of the following corrected amendment and remarks, applicant respectfully request allowance of claims 6 & 8.

ENCL 15



**In The Specification:**

**Change column 2, line 3-7,**

“The system includes a Central Processing Unit (CPU). internal modem, monitor, printer, credit card reading swipe device and housing. Accordingly, besides the objects and advantages of this device/apparatus described previously in my application, several objects and advantages are (some restated):.....”

To:

“The [terminal] includes a Central Processing Unit (CPU). internal modem, monitor, printer, credit card reading swipe device and housing. Accordingly, besides the objects and advantages of this device/apparatus described previously in my application, several objects and advantages are (some restated):.....”

**As modified above, the sentences are supported by the original disclosure, pages 5 & 6.**

**Delete column 2, line 53 through column 3, line 3, deleting from “Numeral 14 generally indicates.....” through column 3, line 3**

**REMARKS**

**The objection to the claims rejection under 35 USC 103.**

The applicant respectfully requests that the rejection be withdrawn and an allowance be granted. The applicant provides the following additional facts (in addition to the expert analysis provide by Mr. Adank and numerous previous factual arguments) to support this request and overcome the examiner’s obviousness arguments.

The examiner insists that three items of prior art “**TouchFax provides the Ultimate in Place-based Interactivity**” (Exhibit E), “**Vision, Power, Versatility Analysis** (Exhibit F) and the “**Shah**” article render the applicants application unpatentable due to obviousness.

The applicant would like the examiner to reconsider the following facts (in addition to what has previously been provided) concerning obviousness rejections and respectfully requests that an allowance be granted.

- **Unexpected Result** The applicant's application provides for an unexpected result. The results achieved by the invention are new, unexpected, superior, unsuggested by any of the relied on prior art.
- **Crowded Art.** The applicant's application is in what can be considered to be Crowded Art. The invention can be classified as a crowded art; therefore, a small step forward should be regarded as significant. The applicant reminds the examiner that the time frame is January 1995.
- **Unsuggested Modification.** The prior art lacks any suggestion that the references should be modified in a manner required to meet the applicant's claims.
- **Misunderstood Reference.** The references do not teach what the examiner relies upon as supposedly teaching. Specifically, a point-of-sale terminal to access the Internet on a pay- as- you use basis.
- **Strained Interpretation.** The examiner has made a strained interpretation of the references that could only be made by hindsight. This was demonstrated by the examiner's refusal to take in to consideration the prior art reference cross walk matrix provided by Mr. Adank, an expert in the art.
- **Solved a Different Problem.** Applicant's invention solves a different problem than the references, and such different problem is recited in the claims. *In re Wright, 6 USPQ 2d 1959 (1988)*

- **No Convincing Reasoning.** The examiner has not presented a convincing line of reasoning as to why the claimed subject matter as a whole, including the differences over prior art, would have been obvious.
- **Unsuggested Combination.** The prior art references do not contain any suggestion (express or implied) that they be combined, or that they be combined as the examiner suggests.
- **Modifications Necessary.** It would be necessary to make modifications, not taught in the prior art, in order to combine the references in the manner suggested by the examiner.
- **Multiplicity of References.** The fact that three references must be combined to meet the invention is unequivocal evidence of unobviousness.

Applicant respectfully requests that the rejection be withdrawn and allowance be provided. The applicant has made a diligent effort to amend the application so that it is at an allowable state that defines a novel structure, unobvious because it produces new and unexpected results at the time of the application. If for any reason the claims of this corrected amendment and response are not believed to be in condition for allowance, the applicant respectfully requests that constructive assistance and suggestions of the examiner pursuant to MPEP 707 07 (j).

Sincerely,

A handwritten signature in black ink, appearing to be 'R. Mettke', with a long horizontal stroke extending to the right.

Richard P. Mettke

Ex parte,

505 Stone Ridge Drive,

Waynesville, MO 65583

Voice: 573-336-5726

FAX: 573-336-7093

Email: [rmettke@aol.com](mailto:rmettke@aol.com)

# Fax

To: MS. STELLA WOO /Group From: Mr. Richard Mettke  
2743

Fax: 703-872-9314

Pages: 6

Phone 703-305-4395

Date: 6/29/02

Re: APPN: 09/134,831

CC:

☒ Urgent ☐ For Review ☐ Please Comment ☐ Please Reply ☐ Please Recycle

Ms. Woo,

In response to the Advisory Action mailed on May 15, 2002, Applicant files the following corrected amendment and response. This response is being filed prior to August 15, 2002 and as such no fees are due. The original copy has been mailed via the US Postal Service.

Best Regards,

  
Richard P. Mettke  
Ex parte,

505 Stone Ridge Drive,  
Waynesville, MO 65583  
573-336-5726  
FAX: 573-336-7093

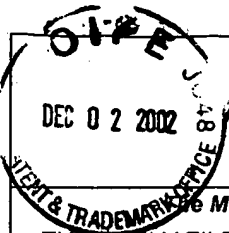
Email: rmettke@aol.com

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\*\* Transmit Conf. Report \*\*

6-25-02



**Advisory Action**

Application No. <b>09/134,831</b>	Applicant(s) <b>Mettke</b>
Examiner <b>Stella Woo</b>	Art Unit <b>2643</b>



THE MAILING DATE of this communication appears on the cover sheet with the correspondence address -

THE REPLY FILED May 29, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see NOTE below);
  - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

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NOTE: The proposed amendment incorrectly states that claims 6 and 8 are pending. As indicated in previous communications, it is claims 6-9 which are pending. Furthermore, Applicant did not delete all subject matter which

3. ☐ Applicant's reply has overcome the following rejection(s): is not supported by the original disclosure.

4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
the claims 6-9 remain obvious in view of the prior art for the same reasons given in the final Office action

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_  
Claim(s) objected to: \_\_\_\_\_  
Claim(s) rejected: 6-9  
Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

10. ☐ Other: \_\_\_\_\_

**STELLA WOO**  
PRIMARY EXAMINER  
ART UNIT 2643

EPCC  
16



6-25-02  
UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/134,831	08/17/1998	RICHARD P. METTKE	6388.005	8517

7590

06/25/2002

Richard Mettke  
505 Stone Ridge Drive  
Waynesville, MO 65583

EXAMINER

WOO, STELLA L

ART UNIT

PAPER NUMBER

2643

DATE MAILED: 06/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Technology Center 2000





EXPEDITED PROCEDURE

Maile  
9-16-02

PPN: 09/134,831

Filed: August 17, 1998

Applicant: Richard P. Mettke

Title: On-line Communications Terminal/Apparatus

Group Art Unit: 2743

Examiner: Stella Woo

**RESPONSE TO ADVISORY ACTION,**  
**DATED June 25, 2002**

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited on \_\_\_\_\_, with the US Postal Service with return receipt requested. The envelope was addressed to Box AF, Commissioner of Patents and Trademark, Washington DC, 220231

Box AF,  
Commissioner of Patents and Trademarks,  
Washington D.C. 20231

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Technology Center 2600

Dear Sir/Madam:

In response to the Advisory Action mailed on June 25, 2002, Applicant files the following response. This response is being filed prior to September 29, 2002 and as such no fees are due. Claims 6 – 9 are pending in the reissue application. An error by the applicant in the previous office action. Applicant respectfully requests allowance of the amended claims.

The applicant has addressed all of the Examiners objections in previous office actions and has removed all material that was not supported in the original disclosure. The applicant requests that the Examiner point out which additional material still remains in the application based on previous responses. Request that the examiner review the packet

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9-16-02

in its entirety and respectfully requests that the rejection be withdrawn and an allowance be granted. The applicant has provided overwhelming evidence to refute the Examiners Obviousness objections.

Again, the Applicant respectfully requests that the rejection be withdrawn and allowance be provided. The applicant has made a diligent effort to amend the application so that it is at an allowable state that defines a novel structure, unobvious because it produces new and unexpected results at the time of the application. If for any reason the claims of this corrected amendment and response are not believed to be in condition for allowance, the applicant respectfully requests that constructive assistance and suggestions of the examiner pursuant to MPEP 707 07 (j).

Sincerely,



Richard P. Mettke

Ex parte,

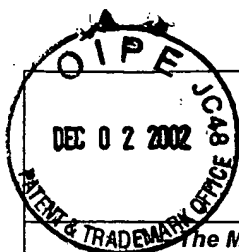
505 Stone Ridge Drive,

Waynesville, MO 65583

Voice: 573-336-5726

FAX: 573-336-7093


Email: rmettke@aol.com



10-11-02

## Advisory Action

Application No. 09/134,831	Applicant(s) Mettke
Examiner Stella Woo	Art Unit 2643



The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Sep 16, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

## THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.


NOTE: \_\_\_\_\_

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3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
the claims remain obvious in view of the prior art for the same reasons given in the final Office action. New matter has not been deleted (see Advisory Action mailed May 15, 2002). Drawings remain unsupported by original disclosure.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_
- Claim(s) objected to: \_\_\_\_\_
- Claim(s) rejected: 6-9
- Claim(s) withdrawn from consideration: \_\_\_\_\_
8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

  
STELLA WOO  
PRIMARY EXAMINER  
ART UNIT 2643

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EXAMINER

WOO, STELLA L

ART UNIT

PAPER NUMBER

2643

DATE MAILED: 10/11/2002

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